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86-1965

No.

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1986

LEE M. SEILER
Petitioner,

VS.

LUCASFILM, LTD., TWENTIETH CENTURY-FOX FILM CORPORATION, GEORGE W. LUCAS, JR., and JOSEPH E. JOHNSTON,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE NINTH CIRCUIT COURT OF APPEALS

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QUESTIONS PRESENTED

1.

In light of the Seventh Amendment to the U.S. Constitution, did the district court have the power to suspend the jury trial in petitioner's action for damages for copyright infringement, conduct a 7-day bench trial on the central issue of the case,—the authenticity and date of creation of the petitioner's artwork in dispute—and then enter a final summary judgment for the respondents, solely on the basis of the court's own negative assessment of the credibility of the petitioner and his several corroborating witnesses?

2.

Assuming *arguendo* the constitutionality of such a proceeding, was it even authorized in this case by the federal "best evidence" rules, F.R.E. 1001 *et seq.*, as the courts below held, in that Congress limited the definition of a "writing" covered by those rules to "letters, words, or numbers, or their equivalent . . . ," F.R.E. 1001(1), presumably excluding artwork?

3.

Assuming *arguendo* that F.R.E. 1001(1) extends to artwork, did F.R.E. 1008 nevertheless require a trial by jury, inasmuch as the central question in dispute was whether the asserted original artwork "ever existed," F.R.E. 1008(a), or "whether other evidence of contents correctly reflect[ed] the contents," F.R.E. 1008(c), of same?

4.

Was a jury trial also required by the provision of the Copyright Act, 17 U.S.C. § 410(c), mandating the admissability and *prima facie* evidentiary weight of certificates of copyright registration, and thus guaranteeing petitioner the right to present and defend before the trier of fact at least those exemplars of his artwork duly accepted by the Copyright Office?

TABLE OF CONTENTS

	Page
Questions presented	i
Parties	1
Opinions below	1
Supreme Court jurisdiction	2
Statutes involved	2
Statement of the case	4
Reasons for granting the writ	8
I	
The outcome-determinative *in limine* bench trial in this case represents a grave threat to the federal guarantee of a trial by jury	8
II	
The Ninth Circuit impermissibly expanded the scope of the Federal Rules of Evidence as determined by Congress in 1975, contrary to the congressional intent to preclude judicial modifications of this very kind	10
III	
The Ninth Circuit has eliminated the strong jury preference enacted in rule 1008 of the federal "best evidence" rules	13
IV	
Finally, the Ninth Circuit has abrogated an important and historical right of all copyright registrants: the right to defend their statutory *prima facie* presumption of copyright validity before the ultimate trier of fact	15
Conclusion	18

TABLE OF AUTHORITIES

Cases

	Page
Apple Computer v. Franklin, 714 F.2d 1240 (3rd Cir. 1983), cert. dismissed under S.Ct. Rule 53, 464 U.S. 1033 (1984)	9
Bailie v. Fisher, 258 F.2d 425 (9th Cir. 1958)	16
Beacon Theatres, Inc. v. Westover, 359 U.S. 500 (1959)	8
Matter of Walker Peterson, 253 U.S. 300 (1919)	8
Ross v. Bernhard, 396 U.S. 531 (1970)	13
Simler v. Conner, 372 U.S. 221 (1963)	9

Constitution

U.S. Constitution, Seventh Amendment ..... i, 2, 8, 9, 18

Statutes

17 U.S.C.:
- § 410(c) ..... passim
- §§ 101 and 407(a) 16

28 U.S.C. § 2076 12
28 U.S.C.A. § 1338(a) 15
Cal. Evid. Code § 250 11
Federal Rules of Civil Procedure, Rule 50(a) 10
37 C.F.R., Ch. II 16

Supreme Court Rules:
- Rule 21.1(a) 1
- Rule 17.1 8

Federal Rules of Evidence:
- Rule 1001, et seq. i
- Rule 1001(1) ..... i, 3, 10, 11
- Rule 1002 ..... 3, 9, 11
- Rule 1004 14
- Rule 1008 ..... passim
- Rule 1008(c) 13

28 U.S.C.A., F.R.E. 701 to end, Legislative History, pp. 613 and 638-40 ..... 11, 12

TABLE OF AUTHORITIES

Other Authorities

Page

5 Louisell & Mueller, Federal Evidence (1981), § 571 . . . 12, 14

Model Code of Evidence, Rule 1(17) 11

Morgan, "The Law of Evidence, 1941-1945," 59 Harv. L.R. 481 (1946) 14

3 Nimmer on Copyright (1985) § 12.11 . . . . . 15, 16

4 Nimmer on Copyright (1985), Appendix 4, House Report on the Copywright Act of 1976 12

5 Weinstein's Evidence (1983), ¶ 1001[01], p. 1001 . . 11, 12, 14

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PETITION FOR A WRIT OF CERTIORARI TO THE NINTH CIRCUIT COURT OF APPEALS

PARTIES

Petitioner, Lee M. Seiler,[1] hereby prays for the issuance of a writ of certiorari to review the judgment herein of the United States Court of Appeals for the Ninth Circuit.

OPINIONS BELOW

The initial judgment and opinion entered by the Ninth Circuit were entered on August 26, 1986. A copy of that opinion, published at 797 F.2d 1504, is reproduced as Appendix A to this petition.

[1] Pursuant to Supreme Court Rule 21.1(a), petitioner notes that the caption of the case in this Court contains the names of all parties to the Ninth Circuit proceeding.

Following a timely petition for rehearing and suggestion of a rehearing *en banc* (see *post*, Supreme Court Jurisdiction), the Ninth Circuit issued a substantially modified opinion on January 26, 1987. A copy of that opinion, published at 808 F.2d 1316, is reproduced as Appendix B.

The district court issued two pertinent opinions. Following the "best evidence" bench trial referred to in the foregoing issue statements, the court issued a memorandum opinion reported at 613 F.Supp. 1253. A copy is reproduced as Appendix C. Then, following a summary judgment motion filed by respondents, the court issued an unpublished memorandum decision granting that motion. A copy is reproduced as Appendix D.

SUPREME COURT JURISDICTION

This petition is timely. Following the original judgment and opinion of the Ninth Circuit, issued on August 26, 1986, petitioner filed a petition for rehearing and suggestion of rehearing *en banc* on September 9, 1986. The modified opinion was issued on January 26, 1987. The petition for rehearing was denied by a subsequent order, copy attached as Appendix E, entered on February 17, 1987. By order dated May 8, 1987, signed by Associate Justice O'Connor, petitioner's time to file his petition for certiorari was extended to and including June 8, 1987.

Subject matter jurisdiction for this petition is conferred by 28 U.S.C. § 1254(a).

STATUTES INVOLVED

U.S. Const., 7th Amendment

In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law.

Federal Rules of Evidence

Rule 1001(1), Writings and recordings:

"Writings" and "recordings" consist of letters, words, or numbers, or their equivalent, set down by handwriting, typewriting, printing, photosating, photographing, magnetic impulse, mechanical or electronic recording, or other form of data compilation.

Rule 1002, Requirement of Original:

To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by Act of Congress.

Rule 1004(1), Originals lost or destroyed:

The original is not required, and other evidence of the contents of a writing, recording, or photograph is admissible if— . . . All originals are lost or have been destroyed, unless the proponent lost or destroyed them in bad faith. . . .

Rule 1008, Functions of Court and Jury:

When the admissibility of other evidence of contents of writings, recordings, or photographs under these rules depends upon the fulfillment of a condition of fact, the question whether the condition has been fulfilled is ordinarily for the court to determine in accordance with the provisions of rule 104. However, when an issue is raised (a) whether the asserted writing ever existed, or (b) whether another writing, recording, or photograph produced at the trial is the original, or (c) whether other evidence of contents correctly reflects the contents, the issue is for the trier of fact to determine as in the case of other issues of fact.

Copyright Act, 17 U.S.C. § 410(c):

In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

STATEMENT OF THE CASE

Petitioner Lee M. Seiler ("Seiler"), commenced this copyright infringement action by complaint filed on February 14, 1983. The complaint demanded substantial damages along with other relief. It also timely demanded a trial by jury, and Seiler never waived that demand.

Seiler, a graphic artist, alleged that the respondents, Lucasfilm, Ltd., Twentieth Century-Fox Film Corporation, George W. Lucas, Jr., and Joseph E. Johnston (collectively, "Lucas") had misappropriated Seiler's artwork in making their science fiction movie, "The Empire Strikes Back." Seiler claimed copying of his original drawings of two large, weapon-bearing walking machines. (The copies annexed to the complaint are reproduced as Appendix F.) His work had been duly accepted for registration by the Copyright Office.

A principal defense theory asserted by Lucas—from his answer to his proposed jury instructions—was that Seiler was falsely claiming the origination of his drawings. The theory was that Seiler actually saw Lucas' equivalent walking machines first, when "The Empire Strikes Back" was released in 1980; and that Seiler only then created and backdated his "original" work for a fraudulent copyright registration, followed by a fraudulent claim of infringement. When Seiler's interrogatory answers revealed that some early versions of his work had been lost or destroyed in the intervening six or seven years, Lucas incorporated that circumstance, too, into his overall theory of a fraudulent copyright claim. In a succinct summary of this defense in a July 10, 1984 pretrial brief, Lucas maintained that, "[T]he works sued upon did not exist at the time of the publication of the defendants' work." (E.R. 310)

In that same pretrial brief, Lucas insisted that his defense of copyright fraud should be tried to the jury, not to the court. Although his attack on the authenticity and date of creation of Seiler's work was interposed as an equitable defense, Lucas correctly asserted that it went "to the heart of plaintiff's claims of copyright infringement. . . ." (E.R. 310) Therefore, Lucas rea-

soned, it could not be removed from the jury trial for a court resolution. Seiler agreed.

Nevertheless, on the eve of the trial, Lucas contended for the first time that his copyright fraud defense should be determined by the court, alone, as a "preliminary fact issue" under Rule 1004 of the Federal Rules of Evidence. In papers filed on September 4, 1984, two days before the pretrial conference, Lucas argued that this defense theory, admittedly going "to the heart of plaintiff's claims" (E.R. 310), should be tried to the court as a "best evidence" objection to the admissibility of Seiler's proffered evidence of his artwork. In open court a week later, Lucas' counsel summarized the purported "best evidence" objection in the familiar terms of the copyright fraud defense:

> We have a great deal of evidence which . . . much of it will be put on through—in the cross-examination of Mr. Seiler, a great deal of evidence, that the originals did not exist as he claims.
>
> Now, that's the—that's the best evidence problem. Not that he destroyed something in bad faith. He never had it. (E.R. 436)

Ironically, the district court initially reacted to Lucas' "best evidence" strategy by stating, "I'm not going to hold up the [jury] trial . . . in order to deal with this." (E.R. 399-400) Indeed, when Lucas' attorneys first began to flesh out their fraud theory, the court tersely replied, "I'm not the jury." (E.R. 443) Not yet.

The court soon fully assumed the role of the trier of ultimate fact in this case, over Seiler's repeated objections that resolving Lucas' challenge to his artwork was "not appropriate at the pretrial stage and is in fact a jury question." (E.R. 416; *see also* E.R. 414-421, 437-438, 478-483)[2] It sent home the jurors and alternates, already selected. It conducted a 7-day evidentiary hearing on the question of when—and indeed whether—Seiler

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[2] On the appeal, Lucas argued that Seiler had "invited the error," if any, by *requesting* the court trial. The Ninth Circuit dismissed that contention out of hand, not even mentioning it in the opinion.

actually originated his drawings. And then it issued a lengthy opinion (Appendix C) setting forth the court's own negative assessment of the credibility of Seiler, and all his corroborating witnesses, as to the origination of his artwork. *All* proffered evidence of that artwork was excluded as suspect "secondary" evidence, even many original drawings, and even the registration certificates and official deposit copies duly accepted by the Copyright Office.

At a status conference after the "best evidence" ruling, the court summarized its holding in the unmistakable terms of Lucas' copyright fraud defense:

> As I indicated as clearly as I could [in the opinion], I did not think that the evidence adduced at our preliminary evidentiary hearing showed that there *ever had been originals of the claimed drawings.* And in looking at the secondary evidence adduced to prove that there were, after the seven days, it was pretty clear to me that there weren't. (E.R. 528) (emphasis added)

The court then acknowledged, however, that a "concept that disturbs me" (*id.*) was the Seventh Amendment jury trial right:

> [A]s you [Seiler's counsel] point out, . . . the jury has—it's the fact finder's job to determine whether the originals ever existed; and that to get a jury trial under the Seventh Amendment you're entitled to have [witnesses] testify before a jury. (*Id.*)

When the court asked Lucas' attorneys for their reaction to the Seventh Amendment problem, they presented a novel and far-reaching concept. The constitutional guarantee of a jury trial could be suspended, they said, whenever the district court sensed a fraudulent claim, one that would be "unfair" to send to a jury:

> That is a vehicle for preventing a fraud like this going before the court—going before a jury. Otherwise there's no purpose in the ['best evidence'] rule. . . . (E.R. 536)

* * *

> . . . I think the court even has discretion to do that to prevent a fraud on itself. *Just because you ask for a jury trial I don't think you can perpetrate a fraud on the court.* (*Id.*, emphasis added)

* * *

> . . . This is not a case where it would be fair under the Seventh Amendment, or any other part of the Constitution, to let a jury—let a jury hear it. (E.R. 538-539)

That is the sole rationale given below for reconciling the "best evidence" proceedings herein with the Seventh Amendment. None of the district court or court of appeals opinions even attempts to make that reconciliation.

A final judgment for Lucas was entered on March 27, 1985. Following the "best evidence" ruling, as summarized in the court's final memorandum and order of March 18, 1985, Lucas had "moved for summary judgment . . . on the obvious ground that, without evidence of the existence of a copyrighted work, plaintiff cannot possibly prevail at trial. " (App. D, p. 41) By excluding all proffered evidence of Seiler's artwork, —even "works that are originals in themselves" (App. D., p. 41) as the court acknowledged—it left Seiler with nothing to show a jury to prove the similarity of Lucas' work, in order to support the inference of copying.

Notice of appeal to the Ninth Circuit followed on April 24, 1985.

REASONS FOR GRANTING THE WRIT

I

THE OUTCOME-DETERMINATIVE *IN LIMINE* BENCH TRIAL IN THIS CASE REPRESENTS A GRAVE THREAT TO THE FEDERAL GUARANTEE OF A TRIAL BY JURY

This Court granted certiorari in the leading case of *Beacon Theatres, Inc. v. Westover,* 359 U.S. 500 (1959), for a reason compellingly applicable here:

> Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care. (*Id.* at 501)

As Seiler vainly argued in the Ninth Circuit, Justice Brandeis wrote long ago for this Court that the nub of the Seventh Amendment's guarantee was "that the ultimate determination of issues of fact by the jury be not interfered with." *Matter of Walker Peterson,* 253 U.S. 300, 309 (1919). As Seiler further pointed out, Rule 1008 of the Federal Rules of Evidence was drafted with precisely that intent. The Advisory Committee Note puts it clearly:

> [Q]uestions may arise which go beyond the mere administration of the rule preferring the original and into the merits of the controversy. . . . The latter portion of the instant rule [1008] is designed to insure treatment of these situations as raising jury questions.

Preservation of the federal right to trial by jury is plainly a matter of "special and important" concern warranting certiorari. Supreme Court Rule 17.1. Moreover, Seiler believes that the opinions below, not even mentioning the Seventh Amendment, but nonetheless approving an unprecedented cancellation of a jury trial, have "so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by the lower court, as to call for an exercise of this Court's power of supervision." Supreme Court Rule 17.1(a).

Seiler had also quoted to the Ninth Circuit this Court's statement in *Simler v. Conner*, 372 U.S. 221, 222 (1963), that "The federal policy favoring jury trials is of historic and continuing strength." Seiler had written that the Ninth Circuit was "today called upon to preserve that policy." (AOB 40) But the Ninth Circuit's opinions, never even mentioning the Seventh Amendment, effectively circumvented it, and also removed the jury trial guarantee from F.R.E. 1008 and Section 410(c) of the Copyright Act.

Accordingly, this case cannot be dismissed as *de minimis* or *sui generis*. A path has been blazed for (1) turning the Seventh Amendment into an impotent exhortation; (2) reversing the intended subordination of the preliminary court issues described by F.R.E. 1004 to the jury issues described by F.R.E. 1008 (see *post*, pp. 13-14); (3) reversing the intended subordination of the whole federal "best evidence" rule to any pertinent "Act of Congress," F.R.E. 1002, such as 17 U.S.C. § 410(c) (see *post*, pp. 11-12); and (4) eliminating an important remedial protection in the Copyright Act for all successful copyright registrants (see *post*, pp. 15-18).

As for the Seventh Amendment, the only pertinent rationale offered below was Lucas' ominous concept that the court, sensing fraud, had the inherent discretionary power to remove this case from the jury. What case turning on a disputed document could not likewise be removed from the jury? There is burgeoning copyright litigation, for example, where the defense could challenge the plaintiff's claimed origination of a computer program. *See, Apple Computer v. Franklin, 714 F.2d 1240 (3rd Cir. 1983), cert. dismissed under S.Ct. Rule 53, 464 U.S. 1033 (1984)*. Even if a jury had been demanded as of right, may not the court, on a "best evidence" challenge, cite *Seiler v. Lucasfilm* and adjudicate the whole case *in limine?* The court might likewise "sense" a fraud, and find it "unfair under the Seventh Amendment" to let the plaintiff's case go to the jury.

The earliest point that the federal trial system permits anything resembling such a step is at the close of the plaintiff's case. Indeed, before Lucas' attorneys hit upon their "best evidence" strategy, their trial brief had concluded as follows:

> [Defendants] feel confident that the Court, after giving plaintiff his day in court, will find that a directed verdict in their favor is appropriate. (E.R. 213)

Seiler, of course, never asked for a guaranteed win at the jury trial, or for the suspension of Rule 50(a) of the Federal Rules of Civil Procedure providing for directed verdicts. He simply asked for the ordinary jury trial right of any federal litigant. That is the important Constitutional right which has been placed in jeopardy by the Ninth Circuit.

II

THE NINTH CIRCUIT IMPERMISSIBLY EXPANDED THE SCOPE OF THE FEDERAL RULES OF EVIDENCE AS DETERMINED BY CONGRESS IN 1975, CONTRARY TO THE CONGRESSIONAL INTENT TO PRECLUDE JUDICIAL MODIFICATIONS OF THIS VERY KIND

There is an entirely independent matter of federal concern in this case: the proper role of the federal judiciary in applying the new Federal Rules of Evidence enacted by Congress in 1975.

Despite the Ninth Circuit's lengthy analysis in concluding that "writings," F.R.E. 1001(1), include an artist's hand drawing of a fantasy walking machine, there is simply no effort to determine the actual Congressional intent in the statutory definition of "writings." Instead, the Ninth Circuit examines what it takes to be the policy reasons for a "best evidence" rule, and concludes that artwork *should* be included within its scope:

> To hold otherwise would frustrate the policies underlying the rule and introduce undesirable inconsistencies into the application of the rule. (App. A., p.4)
>
> * * *
>
> Just as a contract objectively manifests the subjective intent of the makers, so Seiler's drawings are objective manifestations of the creative mind. (*Id.*, p.6)
>
> * * *

> We would be inconsistent to apply the rule to artwork which is literary or photographic but not to artwork of other forms. (*Id.*, p.6)
>
> * * *
>
> Our holding is also supported by the policy served by the best evidence rule in protecting against faulty memory. (*Id.*, p.7)

Just as the Ninth Circuit ignored the Seventh Amendment, it ignored Seiler's textual and historical showing that what *Congress* decided to do in 1975, for good reasons or bad, was restrict the term "writings" to verbally communicative expressions, and to numbers. There were legislative models readily available to Congress of "best evidence" rules that did include artwork, *see, e.g.*, Model Code of Evidence, Rule 1(17); Cal. Evid. Code § 250, and they supplied simple language to accomplish that result. The Ninth Circuit's construction of "letters, words, or numbers, or their equivalent" to include artwork simply defied the plain meaning and intention of Congress. If artwork is the "equivalent" of letters, words, or numbers simply because copies of artwork, too, can be challenged for authenticity, then anything tangible is such an "equivalent." Judicial construction would thus remove any limitation inherent in the language chosen by Congress. *Ejusdem generis* would be flatly disregarded, along with the plain statement of the federal rule drafters that the "equivalent" reference was only meant to take into account modern computer technologies for manipulating *words and figures.* Advisory Committee Note to F.R.E. 1001(1).

> [T]he Advisory Committee deliberately chose not to expand the requirement of an original ["writing"] into areas that are not concerned with words.

5 *Weinstein's Evidence* (1983), ¶ 1001[01], p. 1001-11.

Similarly, the Ninth Circuit ignored the whole subject of Congress' subordination of the general "best evidence" rule to any other pertinent "Act of Congress." F.R.E. 1002. Here, too, Seiler submitted a detailed showing of Congressional intent. Interestingly, the Copyright Act was thoroughly examined and amended in the same 1973-1974 period when the House and Senate

Judiciary Committees were also working on the new Federal Rules of Evidence. (*See,* 4 *Nimmer on Copyright* (1985), Appendix 4, House Report on the Copyright Act of 1976, at pp. 4-5 to 4-9; and 28 U.S.C.A., F.R.E. 701 to End, Legislative History, pp. 613 and 638-40.) As Seiler demonstrated below, the "Act of Congress" limitation in F.R.E. 1002 was not a universal one in the new Federal Rules of Evidence, and reflected a specific intent to subordinate that rule to any other statutes that conferred admissibility, although a "best evidence" objection might otherwise lie.

Seiler went on to document his contention that Section 410(c) of the Copyright Act was precisely the kind of "Act of Congress" that F.R.E. 1002 contemplated. *See, e.g.,* 5 *Weinstein's Evidence, supra,* ¶ 1002[04]; and 5 Louisell & Mueller, *Federal Evidence* (1981), § 571. In a classic example, the deposit copy required for copyright registration, and thus given the *prima facie* protections of 17 U.S.C. § 410(c), is to be the "best edition" of the work, 17 U.S.C. § 407(a), not the *earliest* version which might be required by the "best evidence" rule. Congress plainly intended the latter rule to give way in such a case.

None of this analysis is even acknowledged in the opinions below. No refutation of the apparent Congressional intent is offered. The whole subject is ignored. All that matters in the court's own analysis of policy concerns.

Seiler v. Lucasfilm thus stands as a disturbing precedent on how to resolve questions of the intended scope and coverage of the Federal Rules of Evidence. In 1975, Congress deliberately altered the process of developing rules of evidence in the federal courts. As the legislative history amplifies (*see* 28 U.S.C.A., Federal Rules of Evidence, 701 to End, Legislative History, p. 653), Congress for the first time established legislative control over the federal evidence rules. *See,* 28 U.S.C. § 2076. It is for Congress to relinquish that control, not for the federal courts to grasp it.

There will always, of course, be a need for the judiciary to interpret the 1975 evidence rules. There is also an irreducible element of modification implicit in that process. Here, however, the Ninth Circuit does not even purport to be interpreting. It simply proceeds on the very assumption that Congress made

obsolete in 1975: that evidence rules are as much in the federal courts' domain as any pure common law question. The intended balance needs to be restored.

III

THE NINTH CIRCUIT HAS ELIMINATED THE STRONG JURY PREFERENCE ENACTED IN RULE 1008 OF THE FEDERAL "BEST EVIDENCE" RULES

The Ninth Circuit almost casually eliminated the plain and *only* intention Congress expressed in F.R.E. 1008: that the jury must resolve any outcome-determinative "best evidence" issues, not the court. The record shows that the heart of Lucas' challenge to Seiler's claimed original artwork was whether it "ever existed." F.R.E. 1008(a). Although the Ninth Circuit disagreed,[3] it did acknowledge that Lucas' challenge met the description of F.R.E. 1008(c)—"whether other evidence of contents correctly reflects the contents [of the original]. . . ." Nevertheless, although the rule plainly states that *either* kind of issue "is for the trier of fact to determine as in the case of other issues of fact," the Ninth Circuit concluded that the jury can never do more than evaluate the weight of admitted evidence—that all admissibility rulings remain with the court.

The opinion's single paragraph of explanation on this subject begins by stating that "Seiler's position confuses admissibility of the reconstructions [the court's term for all of Seiler's secondary evidence] with the weight, if any, the trier of fact should give them, after the judge has ruled that they are admissible." (App. A, p. 8) However, the opinion can point to no language in F.R.E. 1008 (or any of Seiler's briefs) suggesting that the rule might

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[3] In a brief footnote (App. A, p. 8) without any discussion of the point, the Ninth Circuit simply adopted Lucas' theory that he had *conceded* the existence of Seiler's originals, mooting any F.R.E. 1008(a) issue. However, all Lucas conceded was that originals existed *after* the release of the subject film, and F.R.E. 1008(a) addresses the "asserted" originals—here, originals created *before* the film. Lucas was certainly challenging the existence of any such originals, and that was an ultimate, outcome-determinative challenge meant to be allocated to the jury.

somehow involve weight, not the basic admissibility of evidence before the trier of fact. Its whole purpose, in fact, is to determine whether the court retains its ordinary control over admissibility rulings when various kinds of issues are raised that can be articulated in "best evidence" terms. Some kinds of challenges, as described in the second sentence of F.R.E. 1008, are *not* to be decided by the court as "preliminary fact issues" determining admissibility. Those kinds of issues are to be reserved for the "trier of fact," F.R.E. 1008, here, the jury. *See*, 5 *Weinstein's Evidence, supra*, ¶ 1008[01], p. 1008-5; Morgan, "The Law of Evidence, 1941-1945," 59 Harv. L.R. 481 (1946); 5 Louisell & Mueller, *supra*, § 613, at pp. 590-591.

There is a well established rule under the Seventh Amendment which should drive the instant point home. When there are legal and equitable issues in a case that might affect each other, this Court has consistently held that the legal issues must be decided first, by the jury. Otherwise, the judge's equitable adjudication would infringe on the Constitutional right to trial by jury. *See, Beacon Theatres, Inc. v. Westover, supra*, 359 U.S. 500; *Ross v. Bernhard*, 396 U.S. 531 (1970).

By the same token, the Ninth Circuit's reading of F.R.E. 1008 reverses its intended and Constitutionally mandated order of priority. As the rule's very structure clearly intends to accomplish, the second sentence, beginning with "However," is meant to allocate certain kinds of issues to the jury which would *otherwise* ("ordinarily") be preliminary fact questions for the court under F.R.E. 1004. The second sentence begins with the dominant "However," plainly controlling over the first sentence, with its subordinate term, "ordinarily."

The Ninth Circuit's reading, though, would make *all* "best evidence" challenges preliminary court issues in the first instance, and only give disputes to the jury if the court rejects the challenge. The jury trial right on outcome-determinative issues is thus rendered impermissibly subordinate to the court's evidentiary function. This construction has broad applicability in the federal courts, and it should be disapproved promptly by this Court.

IV

FINALLY, THE NINTH CIRCUIT HAS ABROGATED AN IMPORTANT AND HISTORICAL RIGHT OF ALL COPYRIGHT REGISTRANTS: THE RIGHT TO DEFEND THEIR STATUTORY *PRIMA FACIE* PRESUMPTION OF COPYRIGHT VALIDITY BEFORE THE ULTIMATE TRIER OF FACT

Congress has expressly mandated that certificates of copyright registration shall not only "constitute evidence," 17 U.S.C. § 410(c), but shall have *prima facie weight* as evidence in proving "the validity of the copyright." *Id.* The Congressional intent can hardly be clearer. The trier of fact *must* be allowed to consider a certificate, including the officially registered work, and determine whether its *prima facie* effect is overcome by other evidence. *See* 3 *Nimmer on Copyright* (1985) ("Nimmer"), § 12.11. Even Lucas had once acknowledged this, by submitting jury instructions on overcoming the *prima facie* effects of the certificates. (E.R. 216-17)

The full text of § 410(c) is as follows:

> In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of registration made thereafter shall be within the discretion of the court.

In this case, while not all of Seiler's copyright registrations took place within five years of the first publication of the registered work, the district court properly ruled that it was giving all of them the full mandatory weight. (E.R. 666) *See Nimmer, supra,* page 12-78.1. Therefore, this appeal equally proceeded on the basis of the mandatory first clause of § 410(c).

The statute provides that the certificates "shall constitute prima facie evidence. . . ." That phrase includes, grammatically, the primary language that the certificates *shall constitute evidence.* Logically and practically, too, a statute mandating *prima*

facie weight for a designated item requires at least that it be admitted in evidence. Section 410(c) reflects a deliberate policy choice that, at a trial, copyright certificates must at least reach the trier of fact. Their *prima facie* effect can only be challenged at that level. Lucas' copyright fraud defense, however characterized, was not for a court to decide *in limine*.

The Copyright Act contains its own rules for the documentation of works, 17 U.S.C. §§ 101 and 407(a) ("the best edition"); its own rules for determining their *prima facie* copyrightability and originality, *passim*; and its own rules for determing whether such a work should be afforded a guarantee of *prima facie* admissibility. § 410 and Part 202 of Rules (37 C.F.R., Ch. II). *All* those rules would be distorted, or supplanted, by any attempt to apply F.R.E. 1001-1008 as the district court did here.

The Copyright Act also reflects a deliberate Congressional judgment that the nation's protection of creative endeavors should rely heavily on an administrative agency, the Copyright Office with its Register of Copyrights. While the federal courts will sit in *review* of the agency's decision, such as the issuance of a registration certificate, the Ninth Circuit itself has held that the review is for abuse of discretion only. *Bailie v. Fisher*, 258 F.2d 425 (9th Cir. 1958). Nor is it an occasion to rewrite plain rules of the Act.

It must be recognized, finally, that granting copyright certificates "automatic *prima facie* weight," 3 *Nimmer, supra*, at p. 12-78, serves fundamental policies of the Copyright Act. As *Nimmer* points out, the Act deliberately gives copyright registrants several important evidentiary advantages in infringement actions. The one involved in this case is vital—the registration certificate automatically establishes the foundational elements of the action, beginning with originality itself. *Nimmer*, pp. 12-78 This rule is intended to relieve the copyright registrant of "an impossible burden," *id.*, such as the burden of proof that he or she "did *not* copy from any other source." *Id.* (original emphasis)

Nevertheless, the Ninth Circuit first held (Appendix A, pp. 9-10) that the bare certificates of registration were admissible, but not the officially deposited artwork which ~~the~~ certificates describe—and indeed which they incorporate by reference. (See

App. B, pp. 19-20, text at fn. 3) But Seiler's petition for rehearing pointed out that divorcing the deposit copy from the certificate in that manner rendered the certificate itself completely ineffectual as evidence before the jury:

> The presumption of copyright validity it is supposed to carry to the jury under § 410(c) willl carry nothing but a cryptic reference to a missing work. (Pet. Reh. p. 4)
>
> * * *
>
> Without the work itself, it would even be impossible to mount a copyright fraud defense, as here, based on a theory of manipulated contents of a drawing. The jury has to see it to disbelieve it. (*Id.*, p. 7)

The Ninth Circuit apparently accepted Seiler's critique, and in any event completely withdrew the Copyright Act portion of the original opinion. However, in the modified opinion (App. B, pp. 19-21), the Ninth Circuit substituted an analysis of § 410(c) that closely resembles its analysis of F.R.E. 1008: the heart of the statute is excised.

The modified opinion holds that, notwithstanding § 410(c), the copyright certificates "do not purport to speak on the ultimate issue of whether Seiler's reconstructions are true to the supposed originals." (App. B, p. 20) Put another way earlier, the opinion states that, "None of the statements in the certificate can be of any use therefore until Seiler proves that the reconstructions are the same as the originals." (*Id.*) Requiring such proof *in limine* as a foundation, the court reasoned, was necessary to prevent copyright fraud.

Thus, as with F.R.E. 1008, here again the Ninth Circuit failed to appreciate that Congress wanted juries to decide such ultimate issues as copyright validity, and the disputed existence and/or contents of original documents. That intention is just as plainly expressed in Copyright Act § 410(c), although implicitly, as in F.R.E. 1008. Yet in both instances, the Ninth Circuit basically reasoned that those issues are too important to be allocated to the jury. Merely because Lucas *challenged* the identity of Seiler's "reconstructions" with his earliest drawings,—a direct challenge to the copyright validity and the statements in Seiler's certifi-

cate—the Ninth Circuit abrogated the intended *prima facie* protection of the Copyright Act. In the illimitable interest of "fraud prevention," Seiler was deprived of his right to have the ultimate trier of fact determine whether Lucas' challenge was well taken—to determine whether this was indeed a case of copyright fraud, or a case of copyright infringement.

CONCLUSION

The disposition of this case below represents a far-reaching challenge to the Constitutional and statutory jury trial right. It affects every copyright registrant in the nation, every proponent of a case-dispositive document ("writing" or not), and ultimately every federal litigant entitled to invoke the Seventh Amendment.

Petitioner therefore submits that this is a "special and important" case, well warranting this Court's attention. The petition should therefore be granted.

Respectfully submitted,

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Appendix A

United States Court of Appeals
for the Ninth Circuit

CA No. 85-1955
DC No. CV-83-696-WHO

Lee M. Seiler
Plaintiff-Appellant,

v.

Lucasfilm, Ltd., Industrial Light and Magic,
Twentieth Century-Fox Film Corporation,
George Lucas, Jr., and Joseph E. Johnston,
Defendants-Appellees.

OPINION

Appeal From the United States District Court For the
Northern District of California
Honorable William H. Orrick, District Judge, Presiding,
Argued and Submitted April 1, 1986
San Francisco, California

[Filed August 26, 1986]

Before: Farris, and Boochever, Circuit Judges, and Keep,* District Judge

Farris, Circuit Judge:

Lee Seiler, a graphic artist and creator of science fiction creatures, copyright infringement by George Lucas and others who created and produced the science fiction movie "The Empire Strikes Back." Seiler claimed that creatures known as "Imperial Walkers" which appeared in The Empire Strikes Back infringed Seiler's copyright on his own creatures called "Garthian Striders." The Empire Strikes Back appeared in 1980; Seiler did not obtain his copyright until 1981.

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* The honorable Judith N. Keep, United States District Judge for the Southern District of California, sitting by designation.

Because Seiler wished to show blown-up comparisons of his creatures and Lucas' Imperial Walkers to the jury at opening statement, the district judge held a pre-trial evidentiary hearing. At the hearing, Seiler could produce no originals of his Garthian Striders nor any documentary evidence that they existed before The Empire Strikes Back appeared in 1980. The district judge, applying the best evidence rule, found that Seiler had lost or destroyed the originals in bad faith under Fed. R. Evid. 1004(1) and denied admissibility of any secondary evidence, even the copies that Seiler had deposited with the Copyright Office. With no admissible evidence, Seiler then lost at summary judgment.

FACTS

Seiler contends that he created and published in 1976 and 1977 science fiction creatures called Garthian Striders. In 1980, George Lucas released The Empire Strikes Back, a motion picture that contains a battle sequence depicting giant machines called Imperial Walkers. In 1981 Seiler obtained a copyright on his Striders, depositing with the Copyright Office "reconstructions" of the originals as they had appeared in 1976 and 1977.

Seiler contends that Lucas' Walkers were copied from Seiler's Striders which were allegedly published in 1976 and 1977. Lucas responds that Seiler did not obtain his copyright until one year after the release of The Empire Strikes Back and that Seiler can produce no documents that antedate The Empire Strikes Back.

Because Seiler proposed to exhibit his Striders in a blow-up comparison to Lucas' Walkers at opening statement, the district judge held an evidentiary hearing on the admissibility of the "reconstructions" of Seiler's Striders. Applying the "best evidence rule," Fed. R. Evid. 1001-1008, the district court found at the end of a seven-day hearing that Seiler lost or destroyed the originals in bad faith under Rule 1004(1) and that consequently no secondary evidence, such as the post-Empire Strikes Back reconstructions, was admissible. In its opinion the court found specifically that Seiler testified falsely, purposefully destroyed or withheld in bad faith the originals, and fabricated and misrepresented the nature of his reconstructions. The district court granted summary judgment to Lucas after the evidentiary hearing.

On appeal, Seiler contends 1) that the best evidence rule does not apply to his works, 2) that if the best evidence rule does apply, Rule 1008 requires a jury determination of the existence and authenticity of his originals, and 3) that 17 U.S.C. § 410(c) of the copyright laws overrides the Federal Rules of Evidence and mandates admission of his secondary evidence.

The appeal was timely; this court has jurisdiction under 28 U.S.C. § 1291. Review of summary judgment is *de novo. Ashton v. Cory*, 780 F.2d 816, 818 (9th Cir. 1986). The issues presented are questions of law, reviewable *de novo. See United States v. McConney*, 728 F.2d 1195, 1201 (9th Cir. 1984) (en banc).

DISCUSSION

1. Application of the best evidence rule.

The best evidence rule embodied in Rules 1001-1008 represented a codification of long standing common law doctrine. Dating back to 1700, the rule requires not, as its common name implies, the best evidence in every case but rather the production of an original document instead of a copy. Many commentators refer to the rule not as the best evidence rule but as the original document rule.

Rule 1001 states: "To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by Act of Congress." Writings and recordings are defined in Rule 1001 as "letters, words, or numbers, or their equivalent, set down by handwriting, typewriting, printing, photostating, photographing, magnetic impulse, mechanical or electronic recording, or other form of data compilation."

The Advisory Committee Note supplies the following gloss:

> Traditionally the rule requiring the original centered upon accumulations of data and expressions affecting legal relations set forth in words and figures. This meant that the rule was one essentially related to writings. Present day techniques have expanded methods of storing data, yet the essential form which the information ultimately assumes for usable purposes is words and figures. Hence the considera-

> tions underlying the rule dictate its expansion to include computers, photographic systems, and other modern developments.

Some treatises, whose approach seems more historical than rigorously analytic, opine without support from any cases that the rule is limited to words and figures. 5 *Weinstein's Evidence* (1983), ¶ 1001(1) [01] at 1001-11; 5 Louisell & Mueller, § 550 at 285.

We hold that Seiler's drawings were "writings" within the meaning of Rule 1001(1); they consist not of "letters, words, or numbers" but of "their equivalent." To hold otherwise would frustrate the policies underlying the rule and introduce undesirable inconsistencies into the application of the rule.

In the days before liberal rules of discovery and modern techniques of electronic copying, the rule guarded against incomplete or fraudulent proof. By requiring the possessor of the original to produce it, the rule prevented the introduction of altered copies and the withholding of originals. The purpose of the rule was thus long thought to be one of fraud prevention, but Wigmore pointed out that the rule operated even in cases where fraud was not at issue, such as where secondary evidence is not admitted even though its proponent acts in utmost good faith. Wigmore also noted that if prevention of fraud were the foundation of the rule, it should apply to objects as well as writings, which it does not. 4 Wigmore, *Evidence* § 1180 (Chadbourn rev. 1972).

The modern justification for the rule has expanded from prevention of fraud to a recognition that writings occupy a central position in the law. When the contents of a writing are at issue, oral testimony as to the terms of the writing is subject to a greater risk of error than oral testimony as to events or other situations. The human memory is not often capable of reciting the precise terms of a writing, and when the terms are in dispute only the writing itself, or a true copy, provides reliable evidence. To summarize then, we observe that the importance of the precise terms of writings in the world of legal relations, the fallibility of the human memory as reliable evidence of the terms, and the hazards of inaccurate or incomplete duplication are the concerns addressed by the best evidence rule. *See* 5 Louisell & Mueller,

Federal Evidence, § 550 at 283; *McCormick on Evidence* (3d ed. 1984) § 231 at 704; Clearly & Strong, The Best Evidence Rule: An Evaluation in Context, 51 Iowa L. Rev. 825, 828 (1966).

Viewing the dispute in the context of the concerns underlying the best evidence rule, we conclude that the rule applies. McCormick summarizes the rule as follows:

> [I]n proving the terms of a writing, where the terms are material, the original writing must be produced unless it is shown to be unavailable for some reason other than the serious fault of the proponent.

McCormick on Evidence § 230, at 704.

The contents of Seiler's work are at issue. There can be no proof of "substantial similarity" and thus of copyright infringement unless Seiler's works are juxtaposed with Lucas' and their contents compared. Since the contents are material and must be proved, Seiler must either produce the original or show that it is unavailable through no fault of his own. Rule 1004(1). This he could not do.

The facts of this case implicate the very concerns that justify the best evidence rule. Seiler alleges infringment by The Empire Strikes Back, but he can produce no documentary evidence of any originals existing before the release of the movie. His secondary evidence does not consist of true copies or exact duplicates but of "reconstructions" made after The Empire Strikes Back. In short, Seiler claims that the movie infringed his originals, yet he has no proof of those originals.

The dangers of fraud in this situation are clear. The rule would ensure that proof of the infringement claim consists of the works alleged to be infringed. Otherwise, "reconstructions" which might have no resemblance to the purported original would suffice as proof for infringement of the original. Furthermore, application of the rule here defers to the rule's special concern for the contents of writings. Seiler's claim depends on the content of the originals, and the rule would exclude reconstituted proof of the originals' content. Under the circumstances here, no "reconstruction" can substitute for the original.

Seiler argues that the best evidence rule does not apply to his work, in that it is artwork rather than "writings, recordings, or photographs." He contends that the rule both historically and currently embraces only words or numbers. Neither party has cited us to cases which discuss the applicability of the rule to drawings.[1]

To recognize Seiler's works as writings does not, as Seiler argues, run counter to the rule's preoccupation with the centrality of the written word in the world of legal relations. Just as a contract objectively manifests the subjective intent of the makers, so Seiler's drawings are objective manifestations of the creative mind. The copyright laws give legal protection to the objective manifestations of an artist's ideas, just as the law of contract protects through its multifarious principles the meeting of minds evidenced in the contract. Comparing Seiler's drawings with Lucas' drawings is no different in principle than evaluating a contract and the intent behind it. Seiler's "reconstructions" are "writings" that affect legal relations; their copyrightability attests to that.

A creative literary work, which is artwork, and a photograph whose contents are sought to be proved, as in copyright, defamation, or invasion of privacy, are both covered by the best evidence rule. *See* McCormick, § 232 at 706 n.9; Advisory Committee's Note to Rule 1002; 5 Louisell & Mueller, § 550 at 285 n.27. We would be inconsistent to apply the rule to artwork which is literary or photographic but not to artwork of other forms. Furthermore, blueprints, engineering drawings, architectural designs may all lack words or numbers yet still be capable of copyright and susceptible to fraudulent alteration. In short, Seiler's argument would have us restrict the definitions of Rule 1001(1) to "words" and "numbers" but ignore "or their equivalent." We will not do so in the circumstances of this case.

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[1] Lucas argues that Seiler's work, involving painting and photographic processes, is photography and therefore under the explicit reach of rule 1001. But the pleadings, Lucas' memoranda in opposition to summary judgment, and the district judge's initial references all characterize Seiler's work as drawings.

Our holding is also supported by the policy served by the best evidence rule in protecting against faulty memory. Seiler's reconstructions were made four to seven years after the alleged originals; his memory as to specifications and dimensions may have dimmed significantly. Furthermore, reconstructions made after the release of The Empire Strikes Back may be tainted, even if unintentionally, by exposure to the movie. Our holding guards against these problems.

2. Rule 1008

As we hold that the district court correctly concluded that the best evidence rule applies to Seiler's drawings, Seiler was required to produce his original drawings unless excused by the exceptions set forth in Rule 1004. The pertinent subsection is 1004(1), which provides.

> The original is not required, and other evidence of the contents of a writing, recording, or photograph is admissible if—
>
> (1) Originals lost or destroyed. All originals are lost or have been destroyed, unless the proponent lost or destroyed them in bad faith;

In the instant case, prior to opening statement, Seiler indicated he planned to show to the jury reconstructions of his "Garthian Striders" during the opening statement. The trial judge would not allow items to be shown to the jury until they were admitted in evidence. Seiler's counsel reiterated that he needed to show the reconstructions to the jury during his opening statement. Hence, the court excused the jury and held a seven-day hearing on their admissibility. At the conclusion of the hearing, the trial judge found that the reconstructions were inadmissible under the best evidence rule as the originals were lost or destroyed in bad faith. This finding is amply supported by the record.

Seiler argues on appeal that regardless of Rule 1004(1), Rule 1008 requires a trial because a key issue would be whether the reconstructions correctly reflect the content of the originals. Rule 1008 provides:

> When the admissibility of other evidence of contents of writings, recordings, or photographs under these rules depends upon the fulfillment of a condition of fact, the question whether the condition has been fulfilled is ordinarily for the court to determine in accordance with the provisions of rule 104. However, when an issue is raised (a) whether the asserted writing ever existed, or (b) whether another writing, recording, or photograph produced at the trial is the original, or (c) whether other evidence of contents correctly reflects the contents, the issue is for the trier of fact to determine as in the case of other issues of fact.[2]

Seiler's position confuses admissibility of the reconstructions with the weight, if any, the trier of fact should give them, after the judge has ruled that they are admissible. Rule 1008 states, in essence, that when the *admissibility* of evidence other then the original depends upon the fulfillment of a condition of fact, the trial judge generally makes the determination of that condition of fact. The notes of the Advisory Committee are consistent with this interpretation in stating: "Most preliminary questions of fact in connection with applying the rule preferring the original as evidence of contents are for the judge . . . [t]hus the question of . . . fulfillment of other conditions specified in Rule 1004 . . . is for the judge." In the instant case, the condition of fact which Seiler needed to prove was that the originals were not lost or destroyed in bad faith. Had he been able to prove this, his reconstructions would have been admissible and then their accuracy would have been a question for the jury. In sum, since admissibility of the reconstructions was dependent upon a finding that the originals were not lost or destroyed in bad faith, the trial judge properly held the hearing to determine their admissibility.

3. Does 17 U.S.C. § 410(c) require the admissibility of the copies of Seiler's work deposited at the Copyright Office?

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[2] Lucas conceded the original existed and Seiler conceded the items he sought to introduce were not the originals. Hence, as subsections (a) and (b) are not in issue, Seiler is arguing that 1008(c) requires that the case be submitted to the jury.

Since Seiler's drawings are within the best evidence rule, we must address the question whether § 410(c) of the Copyright Act mandates their admission in evidence. Section 410(c) states:

> In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded the certificate of a registration made thereafter shall be within the discretion of the court.

Lucas and the district court opinion rely on cases which construe this section as raising a rebuttable presumption of a valid copyright.[3] *See Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980). What Lucas and the district court ignore, however, is the previous threshold question of the admissibility of the certificate. They are correct that, once admitted, the certificate and its presumptive validity may be rebutted and defeated, even at a summary judgment. *Carol Barnhart, Inc. v. Economy Cover Corp.*, 594 F. Supp. 364 (E.D.NY. 1984), *rehg. denied*, 603 F. Supp. 432 (1985), *aff'd.*, 773 F.2d 411 (2d Cir. 1985).

There is no support, however, for denying outright the admission of the certificate. While neither the cases nor Nimmer address the point, the language of § 410(c) requires automatic admission of the certificate. This conclusion is strengthened by reference to the language of § 410(c)'s predecessor, § 209 of the 1909 Act, which provided that the registration certificate "shall be admitted in any court as prima facie evidence of the facts stated therein." 3 *Nimmer on Copyright*, § 12.11 at 12-77 n.2.

Even though the certificate itself is admissible under § 410(c), the statute is unclear as to the admissibility of the copies deposited with the Copyright Office. Congress may have intended to mandate admissibility only of the certificate, or it may have deemed the deposited copies to be incorporated into the certifi-

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[3] Because Seiler's registrations were not all made within 5 years of first publication, it is not clear that all his certificates would be admissible under § 410(c).

cate and therefore admissible as well. The legislative history does not clarify Congress' intentions. *See* H.R. Rep. No. 1476, 94th Cong., 2de Sess. 156-57, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5772-73. No case has addressed this issue, and Nimmer equivocates. 3 *Nimmer on Copyright*, § 12.11[13] at 12-78 n.20.

We hold that when the deposited copies are subject to evidentiary challenge under the best evidence rule, the copies are not deemed to be incorporated into the certificate and are not therefore automatically admissible under § 410(c). This holding allows admissibility of the certificate, so that a party may present presumptive evidence of the validity of the copyright. But the deposited copies, when challenged as not the original documents or true copies, will not share this admissibility or presumption. We limit this holding to situations involving the best evidence rule, and leave for another case the decision as to whether, under other circumstances, the deposited copies may be incorporated in the certificate.

AFFIRMED.

Appendix B

United States Court of Appeals
For the Ninth Circuit

No. 85-1955
CV-83-696-WHO

Lee M. Seiler
Plaintiff-Appellant,

v.

Lucasfilm, Ltd., Industrial light and Magic,
Twentieth Century-Fox Film Coporation,
George Lucas, Jr., and Joseph E. Johnston,
Defendants-Appellees.

MODIFIED OPINION

Argued and Submitted
April 17, 1986—San Francisco, California

Decided August 26, 1986
Filed January 26, 1987

Before: Jerome Farris, and Circuit Boochever, Circuit Judges, and Judith N. Keep,* District Judge

Opinion by Judge Farris

Appeal From the United States District Court
For the Northern District of California
William H. Orrick, District Judge, Presiding

COUNSEL

Bronson, Bronson & McKinnon, Elliot L. Bien, San Francisco, California, for the plaintiff-appellant.

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* The Honorable Judith N. Keep, United States District Judge for the Southern District of California, sitting by designation.

Nutter, Bird, Marella, Boxer, Wolpert & Matz, Joel Boxer, Los Angeles, California; and Keker & Crockett, John Keker and Robert Van Nest, San Francisco, California, for the defendants-appellees.

OPINION

FARRIS, Circuit Judge:

Lee Seiler, a graphic artist and creator of science fiction creatures, alleged copyright infringement by George Lucas and others who created and produced the science fiction movie "The Empire Strikes Back." Seiler claimed that creatures known as "Imperial Walkers" which appeared in The Empire Strikes Back infringed Seiler's copyright on his own creatures called "Garthian Striders." The Empire Strikes Back appeared in 1980; Seiler did not obtain his copyrignt until 1981.

Because Seiler wished to show blown-up comparisons of his creatures and Lucas' Imperial Walkers to the jury at opening statement, the district judge held a pre-trial evidentiary hearing. At the hearing, Seiler could produce no originals of his Garthian Striders nor any documentary evidence that they existed before The Empire Strikes Back appeared in 1980. The district judge, applying the best evidence rule, found that Seiler had lost or destroyed the originals in bad faith under Fed. R. Evid. 1004(1) and denied admissibility of any secondary evidence, even the copies that Seiler had deposited with the Copyright Office. With no admissible evidence, Seiler then lost at summary judgment.

FACTS

Seiler contends that he created and published in 1976 and 1977 science fiction creatures called Garthian Striders. In 1980, George Lucas released The Empire Strikes Back, a motion picture that contains a battle sequence depicting giant machines called Imperial Walkers. In 1981 Seiler obtained a copyright on his Striders, depositing with the Copyright Office "reconstructions" of the originals as they had appeared in 1976 and 1977.

Seiler contends that Lucas' Walkers were copied from Seiler's Striders which were allegedly published in 1976 and 1977. Lucas responds that Seiler did not obtain his copyright until one year after the release of The Empire Strikes Back and that Seiler can produce no documents that antedate The Empire Strikes Back.

Because Seiler proposed to exhibit his Striders in a blow-up comparison to Lucas' Walkers at opening statement, the district judge held an evidentiary hearing on the admissibility of the "reconstructions" of Seilers Striders. Applying the "best evidence rule," Fed. R. Evid. 1001-1008, the district court found at the end of a seven-day hearing that Seiler lost or destroyed the originals in bad faith under Rule 1004(1) and that consequently no secondary evidence, such as the post-Empire Strikes Back reconstructions, was admissible. In its opinion the court found specifically that Seiler testified falsely, purposefully destroyed or withheld in bad faith the originals, and fabricated and misrepresented the nature of his reconstructions. The district court granted summary judgment to Lucas after the evidentiary hearing.

On appeal, Seiler contends 1) That the best evidence rule does not apply to his works, 2) that if the best evidence rule does apply, Rule 1008 requires a jury determination of the existence and authenticity of his originals, and 3) that 17 U.S.C. § 410(c) of the copyright laws overrides the Federal Rules of Evidence and mandates admission of his secondary evidence.

The appeal was timely; this court has jurisdiction under 28 U.S.C. § 1291. Review of summary judgment is *de novo*. *Ashton v. Cory*, 780 F.2d 816, 818 (9th Cir. 1986). The issues presented are questions of law, reviewable *de novo*. *See United States v. McConney*, 728 F.2d 1195, 1201 (9th Cir. 1984) (en banc).

DISCUSSION

1. Application of the best evidence rule.

The best evidence rule embodied in Rules 1001-1008 represented a codification of longstanding common law doctrine. Dating back to 1700, the rule requires not, as its common name implies, the best evidence in every case, but rather the production

of an original document instead of a copy. Many commentators refer to the rule not as the best evidence rule but as the original document rule.

[1] Rule 1001 states: "To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph, is required, except as otherwise provided in these rules or by Act of Congress." Writings and recordings are defined in Rule 1001 as "letters, words, or numbers, or their equivalent, set down by handwriting, typewriting, printing, photostating, photographing, magnetic impulse, mechanical or electronic recording, or other form of data compilation."

The Advisory Committee Note supplies the following gloss:

> Traditionally the rule requiring the original centered upon accumulations of data and expressions affecting legal relations set forth in words and figures. This meant that the rule was one essentially related to writings. Present day techniques have expanded methods of storing data, yet the essential form which the information ultimately assumes for usable purposes is words and figures. Hence the considerations underlying the rule dictate its expansion to include computers, photographic systems, and other modern developments.

Some treatises, whose approach seems more historical than rigorously analytic, opine without support from any cases that the rule is limited to words and figures. 5 *Weinstein's Evidence* (1983), ¶ 1001(1) [01] at 1001-11; 5 Louisell & Mueller, § 550 at 285.

[2] We hold that Seiler's drawings were "writings" within the meaning of Rule 1001(1); they consist not of "letters, words, or numbers" but of "their equivalent." To hold otherwise would frustrate the policies underlying the rule and introduce undesirable inconsistencies into the application of the rule.

In the days before liberal rules of discovery and modern techniques of electronic copying, the rule guarded against incomplete or fraudulent proof. By requiring the possessor of the original to produce it, the rule prevented the introduction of altered copies and the withholding of originals. The purpose of the

rule was thus long thought to be one of fraud prevention, but Wigmore pointed out that the rule operated even in cases where fraud was not at issue, such as where secondary evidence is not admitted even though its proponent acts in utmost good faith. Wigmore also noted that if prevention of fraud were the foundation of the rule, it should apply to objects as well as writings, which it does not. 4 Wigmore, *Evidence* § 1180 (Chadbourn rev. 1972).

[3] The modern justification for the rule has expanded from prevention of fraud to a recognition that writings occupy a central position in the law. When the contents of a writing are at issue, oral testimony as to the terms of the writing is subject to a greater risk of error than oral testimony as to events or other situations. The human memory is not often capable of reciting the precise terms of a writing, and when the terms are in dispute only the writing itself, or a true copy, provides reliable evidence. To summarize then, we observe that the importance of the precise terms of writings in the world of legal relations, the fallibility of the human memory as reliable evidence of the terms, and the hazards of inaccurate or incomplete duplication are the concerns addressed by the best evidence rule. *See* 5 Louisell & Mueller, *Federal Evidence*, § 550 at 283; *McCormick on Evidence* (3d ed. 1984) § 231 at 704; Cleary & Strong, The Best Evidence Rule: An Evaluation in Context, 51 Iowa L. Rev. 825, 828 (1966).

[4] Viewing the dispute in the context of the concerns underlying the best evidence rule, we conclude that the rule applies. McCormick summarizes the rule as follows:

> [I]n proving the terms of a writing, where the terms are material, the original writing must be produced unless it is shown to be unavailable for some reason other than the serious fault of the proponent.

McCormick on Evidence § 230, at 704.

The contents of Seiler's work are at issue. There can be no proof of "substantial similarity" and thus of copyright infringement unless Seiler's works are juxtaposed with Lucas' and their contents compared. Since the contents are material and must be proved, Seiler must either produce the original or show that it is

unavailable through no fault of his own. Rule 1004(1). This he could not do.

The facts of this case implicate the very concerns that justify the best evidence rule. Seiler alleges infringement by The Empire Strikes Back, but he can produce no documentary evidence of any originals existing before the release of the movie. His secondary evidence does not consist of true copies or exact duplicates but of "reconstructions" made after The Empire Strikes Back. In short, Seiler claims that the movie infringed his originals, yet he has no proof of those originals.

[5] The dangers of fraud in this situation are clear. The rule would ensure that proof of the infringement claim consists of the works alleged to be infringed. Otherwise, "reconstructions" which might have no resemblance to the purported original would suffice as proof for infringement of the original. Furthermore, application of the rule here defers to the rule's special concern for the contents of writings. Seiler's claim depends on the content of the originals, and the rule would exclude reconstituted proof of the originals' content. Under the circumstances here, no "reconstruction" can substitute for the original.

Seiler argues that the best evidence rule does not apply to his work, in that it is artwork rather than "writings, recordings, or photographs." He contends that the rule both historically and currently embraces only words or numbers. Neither party has cited us to cases which discuss the applicability of the rule to drawings.[1]

[6] To recognize Seiler's works as writing does not, as Seiler argues, run counter to the rule's preoccupation with the centrality of the written word in the world of legal relations. Just as a contract objectively manifests the subjective intent of the makers, so Seiler's drawings are objective manifestations of the creative

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[1] Lucas argues that Seiler's work, involving painting and photographic processes, is photography and therefore under the explicit reach of rule 1001. But the pleadings, Lucas' memoranda in opposition to summary judgment, and the district judge's initial references all characterize Seiler's work as drawings.

mind. The copyright laws give legal protection to the objective manifestations of an artist's ideas, just as the law of contract protects through its multifarious principles the meeting of minds evidenced in the contract. Comparing Seiler's drawings with Lucas' drawings is no different in principle than evaluating a contract and the intent behind it. Seiler's "reconstructions" are "writings" that affect legal relations; their copyrightability attests to that.

A creative literary work, which is artwork, and a photograph whose contents are sought to be proved, as in copyright, defamation, or invasion of privacy, are both covered by the best evidence rule. *See* McCormick, § 232 at 706 n.9; Advisory Committee's Note to Rule 1002; 5 Louisell & Mueller, § 550 at 285 n.27. We would be inconsistent to apply the rule to artwork which is literary or photographic but not to artwork of other forms. Furthermore, blueprints, engineering drawings, architectural designs may all lack words or numbers yet still be capable of copyright and susceptible to fraudulent alteration. In short, Seiler's argument would have us restrict the definitions of Rule 1001(1) to "words" and "numbers" but ignore "or their equivalent." We will not do so in the circumstances of this case.

[7] Our holding is also supported by the policy served by the best evidence rule in protecting against faulty memory. Seiler's reconstructions were made four to seven years after the alleged originals; his memory as to specifications and dimensions may have dimmed significantly. Furthermore, reconstructions made after the release of The Empire Strikes Back may be tainted, even if unintentionally, by exposure to the movie. Our holding guards against these problems.

2. Rule 1008

[8] As we hold that the district court correctly concluded that the best evidence rule applies to Seiler's drawings, Seiler was required to produce his original drawings unless excused by the exceptions set forth in Rule 1004. The pertinent subsection is 1004(1), which provides:

> The original is not required, and other evidence of the contents of a writing, recording, or photograph is admissible if—
>
> > (1) Originals lost or destroyed. All originals are lost or have been destroyed, unless the proponent lost or destroyed them in bad faith;

[9] In the instant case, prior to opening statement, Seiler indicated he planned to show to the jury reconstructions of his "Garthian Striders" during the opening statement. The trial judge would not allow items to be shown to the jury until they were admitted in evidence. Seiler's counsel reiterated that he needed to show the reconstructions to the jury during his opening statement. Hence, the court excused the jury and held a seven-day hearing on their admissibility. At the conclusion of the hearing, the trial judge found that the reconstructions were inadmissible under the best evidence rule as the originals were lost or destroyed in bad faith. This finding is amply supported by the record.

Seiler argues on appeal that regardless of Rule 1004(1), Rule 1008 requires a trial because a key issue would be whether the reconstructions correctly reflect the content of the originals. Rule 1008 provides:

> When the admissibility of other evidence of contents of writings, recordings, or photographs under these rules depends upon the fulfillment of a condition of fact, the question whether the condition has been fulfilled is ordinarily for the court to determine in accordance with the provisions of rule 104. However, when an issue is raised (a) whether the asserted writing ever existed, or (b) whether another writing, recording, or photograph produced at the trial is the original, or (c) whether other evidence of contents correctly reflects the contents, the issue is for the trier of facts to determine as in the case of other issues of fact.[2]

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[2] Lucas conceded the originals existed and Seiler conceded the items he sought to introduce were not the originals. Hence, as subsections (a) and (b) are not in issue, Seiler is arguing that 1008(c) requires that the case be submitted to the jury.

[10] Seiler's position confuses admissibility of the reconstructions with the weight, if any, the trier of fact should give them, after the judge has ruled that they are admissible. Rule 1008 states, in essence, that when the *admissibility* of evidence other than the original depends upon the fulfillment of a condition of fact, the trial judge generally makes the determination of that condition of fact. The notes of the Advisory Committee are consistent with this interpretation in stating: "Most preliminary questions of fact in connection with applying the rule preferring the original as evidence of contents are for the judge . . . [t]hus the question of . . . fulfillment of other conditions specified in rule 1004 . . . is for the judge." In the instant case, the condition of fact which Seiler needed to prove was that the originals were not lost or destroyed in bad faith. Had he been able to prove this, his reconstructions would have been admissible and then their accuracy would have been a question for the jury. In sum, since admissibility of the reconstructions was dependent upon finding that the originals were not lost or destroyed in bad faith, the trial judge properly held the hearing to determine their admissibility.

3. Does 17 U.S.C. § 410(c) require the admission of the copies of Seiler's work deposited at the Copyright Office?

Seiler contends that § 410(c) of the Copyright Act mandates the admission of his reconstructions in evidence despite the district court's ruling that they are excluded under the best evidence rule. Section 410(c) provides:

> In any judicial proceedings the certificate of a registration made before or within five years after first publication of the work shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate. The evidentiary weight to be accorded in the certificate of a registration made thereafter shall be within the discretion of the court.

Seiler argues that this section requires the admission of the copyright certificate he obtained on his reconstructions in 1981 and, more importantly, the attached "work" that Seiler claims is

incorporated in the certificate by reference.[3] We hold that § 410(c) has no application here, because the certificate of copyright has no bearing upon the ultimate facts Seiler seeks to prove by its submission.

[11] Section 410(c) makes the copyright certificate prima facie evidence of "the validity of the copyright and of the facts stated in the certificate." Seiler's copyright claims are based entirely upon the original drawings, which he claims were first published in 1977. He has sought to present his reconstructed drawings as a substitute for the originals that apparently no longer exist. To accomplish this, he must show that the reconstructions are virtually identical to those originals. All of the recitations in the certificate pertain to the attached "work," which is Seiler's reconstructions. None of the statements in the certificate can be of any use therefore until Seiler proves that the reconstructions are the same as the originals. Prima facie evidence of statements in the certificate is irrelevant until that proof has been made.

[12] Moreover, the certificate obtained in 1981 and the attached reconstructions do not purport to speak on the ultimate issue of whether Seiler's reconstructions are true to the supposed originals. In fact, no indication appears on the certificate that the Copyright Office was even aware that the attached "work" was reconstructed, and not a true copy of the original work.[4] Seiler has not presented his application for a certificate, or any other

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[3] The certificate attests: "This certificate, issued under the seal of the Copyright Office in accordance with the provisions of section 410(a) of title 17, United States Code, attests that copyright registration has been made for the work below." The certificate gives the title of the work as "GARTHIAN CULTURE (2 PARTS)," and certifies that it was created in 1976 and first published on June 1, 1977, by Inland Printing Co. The certificate is a form, apparently completed by the applicant.

[4] There is one space on the certificate in which Seiler might have indicated that his submission was only a reconstruction of earlier work that he wished to copyright. This section of the form is headed "Compilation or Derivative Work," and asks the artist to "[i]dentify any preexisting work this work is based on or incorporates." This part has been left blank.

evidence indicating that he advised the Copyright Office of the nature of the work he was submitting. The Copyright Act does not contemplate the copyrighting of a now non-existent original on the basis of a tendered reconstruction. Section 408 specifies the types of material that must be deposited along with an application for a certificate. The permissible materials include bona fide copies of the original work only; there is no mention of "reconstructions." If it were otherwise, the possibilities for fraud would be limitless. Further, section 410(c) merely provides that the certification of registration shall constitute prima facie evidence of the validity of facts stated in the copyright certificate. When, as here a reconstruction was attached to the certificate, it was no abuse of the court's discretion to conduct the pre-trial hearing which resulted in the finding that Seiler had lost or destroyed the originals in bad faith. That finding overcomes any presumption afforded the attachment to the certificate by virtue of section 410(c).

The certificate of copyright registration is not evidence of any material fact in Seiler's case. Section 410(c) does not compel its submission.

AFFIRMED.

Appendix C

United States District Court
Northern District of California
No. C-83-0696 WHO

Lee M. Seiler,
Plaintiff,

vs.

Lucasfilm, Ltd., Twentieth Century Fox
Film Corporation,
George W. Lucas, Jr., and
Joseph E. Johnston,
Defendants.

Opinion
Filed October 16, 1984

This copyright case is based upon charges by plaintiff that defendant creators and producers of the movie "The Empire Strikes Back" ("ESB") copied some of his drawings for use in that film. Plaintiff possesses no originals of any of the work he contends was copied by defendants. In fact, plaintiff has been unable to produce any neutral third party who currently has in his or her possession an original or duplicate of the works in issue which that person possessed prior to the release of ESB. Instead, plaintiff seeks to introduce secondary evidence in the form of copies, reconstructions, projections, and the like in lieu of the originals in order to establish the content of those originals. The question presently before the Court is whether plaintiff can show as required by Federal Rule of Evidence 1004 that he did not lose or destroy the originals of his drawings in bad faith. The evidence offered by plaintiff is so inherently and overwhelmingly unbelievable that the Court finds that plaintiff has failed to meet his burden on the preliminary issue of loss or destruction without bad faith. Therefore, all secondary evidence offered to prove the contents of the missing originals is inadmissible.

I

On February 14, 1983, plaintiff Lee M. Seiler filed a complaint against defendants Lucasfilm, Ltd., Twentieth Century-Fox Film Corporation, George W. Lucas, Jr., and Joseph E. Johnston arising out of defendant's alleged copying of plaintiff's artwork. Plaintiff's amended nine-count complaint alleges that three of his Garthian Strider designs ("striders") were unlawfully appropriated by defendants for use in the film ESB, a sequel to "Star Wars."[1] The striders originally in issue were (1) the AO 785/2 "Garthian Sprinter" ("AO 785/2"), (2) the AO-34E "Garthian Walker" ("AO 34E"), and (3) the 788 "Roundheaded Strider" ("788"). Plaintiff has since admitted that the 788 was not copied by defendants. As such, that strider is no longer in suit. Plaintiff seeks injunctive relief, monetary damages measured by defendants' revenues, imposition of a constructive trust over all profits and advancements derived from the works allegedly copied, and for punitive damages.

Plaintiff's first six causes of action are for copyright infringement; plaintiff alleges that defendants copied from all or some of four different publications. The seventh cause of action alleges violation of the Trademark Act of 1946, 15 U.S.C. §§ 1051 *et seq.* The eighth cause of action alleges various unfair competition practices in violation of California Business and Professions Code §§ 17200 *et seq.*, and the ninth cause of action seeks imposition of a constructive trust over all revenue received as a result of patent No. 266,777 owned by defendants Lucas and Johnston.[2]

The Court, acting pursuant to Federal Rule of Evidence 104(a), granted the parties' motions for an evidentiary hearing in

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[1] Plaintiff also filed two related lawsuits. One is identical to this lawsuit except that the complaint alleges infringement in "Return of the Jedi," another sequel to "Star Wars." The other lawsuit is against commercial licensees of defendants Lucasfilm and Twentieth-Century Fox for secondary infringements through products using the contested designs. All three cases were consolidated for discovery.

[2] The trial of this case was bifurcated, so that the parties would first try the question of defendant's use of plaintiff's works in the movie ESB, and then if necessary, the issue of relief.

order to determine the preliminary question of whether the originals were lost or destroyed in bad faith. The Court heard testimony over seven days fron nine witnesses presented by plaintiff and five witnesses presented by defendants, and viewed in excess of one hundred documentary exhibits.

On September 25, 1984, counsel for the parties submitted their proposed findings of fact. On September 26, 1984, parties' counsel submitted counterfindings of fact and also conclusions of law. Both parties also briefed the nature of the evidentiary hearing conducted by the Court, the applicability of Federal Rules of evidence 104, 1004, and 1008 to the findings and counterfindings, and the proper standard to be applied by the Court in analyzing the evidence proffered at the hearing. On October 1, 1984, the parties orally argued their positions to the Court, whereupon the matter was taken under submission.

At the outset, the Court repeats for emphasis that the great bulk of plaintiff's testimony was unbelievable, often, bordering on the incredible. Plaintiff testified extensively concerning the "facts" surrounding the destruction and loss of plaintiff's originals, only to materially alter his version of those facts upon cross examination, and often again upon redirect and recross examination. Not surprisingly, the majority of these bizarre "facts" were not corroborated by any neutral or independent third party.[3] In particular, plaintiff's version of the circumstances surrounding the destruction of his originals by flood, was inherently unbelievable and disturbingly contradictory. In sum, it appears to the Court that the absence of any originals of the works in suit, or even a single copy produced by any independent third party that was possessed by that third party prior to the release of ESB, is far from accidental or providential. Accordingly, the testimony and other evidence adduced by plaintiff at the evidentiary hearing does not meet the even minimal showing required under Federal

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[3] Those persons who did provide corroboration of the loss and destruction of plaintiff's originals were persons arguably under the "control" of plaintiff: his wife, and his business partner who admitted to having a contingency interest in the suit.

Rule of Evidence 1004 in order to justify admission of secondary evidence to prove the contents of the missing originals.

A. *Background.*

Plaintiff is an artist and designer of science fiction creatures and machines. Plaintiff began creating a "family" of Garthian striders some time prior to the release of ESB to the public. Plaintiff claims that the two works in issue in this suit, the AO785/2 and the AO34E are part of this family of striders. Some of the publications containing the works in suit are claimed to have been first published as early as 1976; others are claimed to have been first published in 1977. The publications were not registered with the United States Copyright Office until 1981, 1982, and 1983. The movie that is the subject of this suit was first relased in May 1980, although certain promotional portions of the movie were released for public viewing several months prior to May 1980.

B. Plaintiff is Skilled in Reproduction Techniques.

Plaintiff is skilled in various reproduction techniques, including making blueprint and offset materials. He has often made his own negative and positive reproductions without the use of outside vendors. Plaintiff has often created several versions of the same basic material. Plaintiff has transposed portions from one or more sets of materials onto other subsequently-created materials, utilizing cut-and-paste and other reconstruction techniques. Plaintiff's business practice is to reuse portions of his existing graphic materials on subsequent materials.

C. Destruction of Originals by Flood.

Plaintiff claims that the vast majority of his original artwork, including original artwork depicting the AO785/2 and AO34E, was destroyed in 1979 by "flood." Such materials were allegedly stored underneath a geodesic dome house that plaintiff was in the process of building in Boonville, California. The house consisted of a geodesic dome placed upon a wooden platform. According to plaintiff, the area beneath the dome where the materials were stored consisted of dirt and gravel, was probably open on three sides and fenced in on the remaining side by chicken wire, or entirely fenced in by chicken wire. Plaintiff claims that all of his

original artwork stored in cardboard boxes underneath the dome house in this dirt and gravel area were completely destroyed by some sort of extensive water damage, such that the entirety of those materials had to be discarded at the Mendocino dump.

The Court finds that the testimony concerning the water damage and the resulting destruction of the bulk of plaintiff's original artwork, was inherently unbelievable, contradictory, and unsupported by the testimony of neutral witnesses. The Court's finding is based upon the following:

1. Plaintiff testified at the first session of his deposition that he discovered the damage to his artwork stored underneath the dome house when he first returned to the dome house in July or August 1979. Plaintiff also testified at that time that he did not add any additional material to the material already stored, but immediately discarded the damaged material. At a later deposition session and at the evidentiary hearing, however, plaintiff testified that he did not discover the water damage to the stored materials until six or eight weeks (or longer) after he returned to the dome house, and that, although he was aware of the damage sustained by the stored materials, he added as many as twelve more boxes of original material to those already stored under the dome. It was not until some time in September 1979 that plaintiff rediscovered the damage and discarded the entire store of boxes containing the artwork.

2. Plaintiff testified in several deposition sessions, and upon direct examination at the evidentiary hearing, that all of the original artwork stored underneath the dome house was damaged beyond restoration or use, and that plaintiff discarded all of the boxes containing those materials at the Mendocino dump. Halfway through the evidentiary hearing, however, plaintiff suddenly recalled that he had in fact saved 100 boxes of original artwork and other such materials. Plaintiff did not testify as to what happened to the materials contained in those 100 salvaged boxes.

3. The testimony concerning the number of boxes, and hence, the amount of artwork stored under the dome house was contradictory. Plaintiff's wife, Mary Graves, testified that there were approximately 30 to 50 boxes stored, and that the boxes were

stacked about four feet high. Plaintiff, on the other hand, testified that approximately 140 boxes were stored underneath the dome house.

4. Neither plaintiff, nor any other witness offered by plaintiff, could explain the source of the water that plaintiff claims completely destroyed his original artwork. Plaintiff testified that the soil comprising the dirt and gravel floor upon which his work was stored was very wet soil, and that he had installed a drainage pipe underneath the dome in order to siphon off any excess runoff. Yet, plaintiff offered no explanation for how such wet soil could completely soak and damage beyond salvage boxes that were stacked four feet from the soil. Although Graves testified that she saw water on top of the stacked boxes, plaintiff could offer no evidence of any rainfall in the summer months in which the water damage allegedly occurred, no leakage from household plumbing, or any other such plausible explanation for the extensive water damage suffered. Additionally, plaintiff testified that the damage to the boxes was uniformly complete, requiring that all boxes be discarded. Yet plaintiff offered no explanation for how, in a mere six to eight week period of time, such damage could occur to newly stored boxes to the same extent as boxes previously stored under the house.

5. Graves testified that she had ten boxes containing her personal belongings also stored underneath the dome along with plaintiff's artwork, and that the boxes were equally unprotected from water and other elements. Graves also testified that her ten boxes survived the water incident without suffering any water damage.

6. Although Graves testified that she was not physically present when plaintiff discovered and discarded the boxes stored under the dome house, she testified that she was somehow able to salvage two pieces of artwork. Those two items are two different plans, one happening to depict the AO785/2, and the other happening to depict the AO34E, the works in issue in this suit. Graves testified further that she "baked" these plans in order to dry them out, although she offered contradictory testimony concerning where and when this baking was done. Graves said that she did not tell plaintiff that she was able to save the two pieces of

artwork until 1981, some time after plaintiff had first contacted defendants with charges of unlawful appropriation of the very designs depicted on the two pieces of salvaged artwork.

7. The existence of the "flood" and the almost complete destruction of the vast majority of plaintiff's original artwork including the designs in issue in this suit, cannot be corroborated by any neutral or independent party.

8. Neither plaintiff nor Graves could remember with any certainty whether either one of them conducted an extensive search through the boxes in order to determine which items, if any, contained therein were salvageable before discarding the entire store of boxes.

9. Plaintiff took no photographs of the claimed damage, nor did he produce any documentary evidence supporting the existence of the damage.

10. Plaintiff made no insurance claim for damage caused by the incident.

D. Bad Faith Nonproduction.

The Court finds that the originals of the AO785/2 and AO34E were not destroyed by water in the dome house incident in 1979, but that the originals depicting those works have been purposefully destroyed or withheld from production. The finding is based on the following:

1. Plaintiff claims that he and Graves sold copies of the AO785/2 and AO34E at the San Jose Fantasy Convention in February 1979. Photographs of plaintiff's booth at that convention, however, do not reveal the presence of drawings or other materials containing either of the works in issue, although many of plaintiff's other unrelated works are clearly depicted. The sign posted at plaintiff's booth during that convention refers to the Garthian Strider in the singular;[4] both parties admit that plaintiff sold the 788 strider, not in issue in this suit, at that convention. Four independent witnesses testified that they visited plaintiff's

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[4] The sign states: "Blue Prints of the Garthian Strider. You Can Build It!!" when referring to the strider plans for sale.

booth at the convention and, although they confirmed the existence of the 788 strider, none saw any materials depicting, or referring to, the AO785/2 or AO34E. None of the witnesses were told by plaintiff about any striders other than the 788, although at least two of the witnesses recall talking to plaintiff extensively about plaintiff's strider materials. Finally, plaintiff's business partner at the time, Mitsuro Ikuta, testified that he does not remember any of the works in issue available at the San Jose Fantasy Convention.

2. In December, 1978, plaintiff and Ikuta wrote to the Japanese publishers of *Starlog* magazine listing the products that they had available for sale, as well as products that were not currently available, but contemplated to be so in the near future. The 788 strider was identified as "first in a series"; and although plaintiff claims that the AO785/2 and AO34E were in existence and available for sale in 1978, no mention was made of either of those works in the letter.

3. Although plaintiff placed advertisements in several magazines during 1979 and 1980 advertising the 788 strider and other unrelated materials, none of the advertisements refer to the AO785/2 or the AO34E.

4. Plaintiff has no records prior to the time of his access to ESB materials of any customer orders or customer correspondence depicting or referencing the AO785/2 or AO34E.

5. Product order codes utilized by Graves in 1979 and 1980 to account for customer orders by product did not contain differentiation betweem striders ordered, as was the case for other materials of which there were multiple versions sold by plaintiff. Graves testified that, although multiple striders were for sale in 1979, only the 788 strider was available for sale in 1980.

6. Shortly after the release of ESB, plaintiff drafted a letter to Dan Dawes, attorney for defendant Lucasfilm, in which plaintiff discussed materials he considered to be infringed upon by defendants; none of the materials identified are the AO785/2 or the AO34E.

7. In late 1982, after plaintiff retained attorneys for this lawsuit, plaintiff sent out a survey to over 2,500 persons from plaintiff's mailing list inquiring whether any of those persons currently possesses or at one time possessed a copy of the AO785/2 or AO34E.[5] The survey also asked whether any customer had any interest in ordering or "replacing" such materials at a 30 percent discount. The results of the survey did not produce anyone who possesses or possessed a copy of the AO785/2 or AO34E. As a follow-up to this survey, plaintiff sent any person who responded indicating an interest in receiving plaintiff's works, a free complimentary copy of the plans of the AO785/2 and AO34E, products the follow-up letter identified as having been sold in the past.

8. Plaintiff filed with the United States Copyright Office copyright registration applications for the works in issue. Plaintiff did not attach as the deposit sample of his works either originals, or duplicates, produced at the time of first publication. Rather, plaintiff "reconstructed" the publications as he claimed they appeared upon first publication in 1976 or 1977. Several of the deposit copies contain text which is internally inconsistent, as well as inconsistent with the artwork accompanying the text. Additionally, at least one of the advertising fliers claimed to have been published in 1976 was in fact never published, but was instead a proof copy.

9. Neither plaintiff nor any witness possesses originals of the AO785/2 or AO34E.

10. No independent third party possessses copies of the AO785/2 or AO34E which that person possessed prior to 1980.

E. Fabricated Evidence.

Plaintiff seeks to introduce a variety of secondary evidence for the purpose of proving the contents of the missing originals. The Court finds that much of this evidence has been fabricated or misrepresented to the Court. In particular, the Court finds the following:

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[5] The survey also inquired about two other striders.

1. The Samuel Comstock letter and accompanying flier depicting the AO34E could not have existed in its present form prior to 1980, although the envelope bears a 1979 postmark date.

2. The document containing the note to "Mitch" Ikuta dated 12/76, indicating plaintiff would visit Ikuta in a few days, did not exist as dated, because plaintiff was living in Ames, Iowa, during the period in question. Ikuta testified that he was unfamiliar with the document.

3. The half-inch videotape containing snippets depicting plaintiff's original garthian materials was not filmed in 1978 as plaintiff claims. Plaintiff testified at his deposition that no copies of the videotape inventory had been made and the the original three-quarter inch videotape had been lost. The videotape that is claimed to be a copy of this "lost" three-quarter inch tape is on one-half inch tape and is a third or fourth generation copy. Plaintiff's explanation as to its present condition was unsatisfactory and purposefully confusing. Additionally, segments plaintiff contends were taped in 1979 are strikingly similar to segments plaintiff contends were taped in 1978, including the lighting, camera angle, background music, and position of desk blotter stamp, indicating that all of the segments were created at the same time. The claimed 1978 segment containing a piece of paper with "1978" written upon it was created purposefully to misrepresent the true date of the tape's creation.

4. The blueprint plans "found" by Ikuta in his briefcase were not placed in that briefcase prior to 1978, as Ikuta contends. At Ikuta's first day of depositon on June 28, 1983, Ikuta responded to a subpoena requiring production by producing a copy of a 1980 printed version of the *The Garthian Culture*, contending that he had retrieved it from a briefcase that had been locked and unopened since 1978. On the second day of his deposition, Ikuta produced a large number of blueprints depicting the AO785/2 and AO34E, claiming that, although he had previously conducted a thorough search of the briefcase in compliance with the subpoena, he had "overlooked" the bulky plans he produced on the second day. The briefcase in which the documents were found is a regular-sized briefcase, approximately four inches thick.

5. The film "found" by Ikuta in his freezer was not placed in that freezer in 1978, as Ikuta contends. Ikuta testified that he had found the film in the freezer compartment of a refrigerator Ikuta shared with the plaintiff, that the film had been there since 1978, but that he had never before noticed the presence of the film in the freezer. The freezer compartment is admitted to be only about two or three cubic feet in size, and has not been defrosted since 1976. The box containing the film does not suffer from "freezer burn" or other such damage. Ikuta has a 4 percent contingency interest in the lawsuit.

6. The materials found by Graves that were "found" in early 1984 in a storage box containing kitchen goods were not placed there in 1979. The box was stored in a commercial storage unit that Graves shares with plaintiff. Graves testified the she found the documents as "filler" among kichen goods that she packed in 1979, that she doesn't recall placing the documents in with her pesonal kitchen items, that the box has remained unopened since 1979, even though Graves has moved six times during that time period, and that she has no idea how the documents came to be in her personal storage box. Graves further testified that she did not search her personal boxes in connection with this suit prior to 1984, despite the obvious importance of locating these exhibits.

7. The plans claimed to be salvaged from the dome house water incident and "baked" by Graves, contain pictures of the AO785/2, which has one continuous canopy in the place of eyes, yet the text accompanying that picture refers to "compound eyes." The 788 strider, not an issue in this suit, contains compound eyes.

F. *Testimony of Independent Witnesses.*

Plaintiff called to testify six independent witnesses, in order to establish that the original of the AO785/2 an AO34E were destroyed or lost without bad faith, and that such documents were in existence prior to the release of ESB. After careful consideration of each witnesses' testimony, this Court finds:

1. None of the witnesses possess an original or copy of the AO785/2 or AO34E which that witness possessed prior to 1980.

2. None of the witnesses were able to postively and consistently identify the AO785/2 or AO34E as being in existence prior to 1980.

G. *Conclusion.*

In sum, based upon seven days of testimony elicited from fourteen witnesses, and careful consideration of over one hundred exhibits, the Court finds that:

1. Plaintiff testified falsely as to the destruction of the original artwork depicting the AO785/2 and AO34E in a 1979 "flood" underneath his Boonville dome house.

2. Plaintiff purposefully destroyed or withheld in bad faith the original artwork depicting the AO785/2 and AO34E.

3. Plaintiff fabricated and misrepresented the nature of secondary evidence for use in this lawsuit.

II.

A. *Application fo Federal Rule of Evidence 1004.*

Federal Rule of Evidence 104(a) provides that preliminary questions concerning the admissibility of evidence shall be determined by the court. Fed. R. Evid. 104(a). Federal Rules of Evidence 1004 and 1008 further delineate the duty of the court in determining preliminary questions regarding admissibility. Rule 1004 provides that secondary evidence of the contents of a writing, recording, or photograph is admissible unless the proponent of the evidence lost or destroyed the originals in bad faith. Fed. R. Evid. 1004(1). Rule 1008 states that the determination of whether a condition has been fulfilled is ordinarily for the court to decide. Therefore, Rule 1004 read in conjunction with Rule 1008 makes the determination of whether the proponent of the evidence has established that all the originals were lost or destroyed without bad faith a question for the court. Rule 1008 provides further that the trier of fact is to determine the question of whether the originals ever existed. Fed. R. Evid. 1008.

The burden of proving loss or destruction under Rule 1004 is on the proponent of the evidence. *See* 5 Weinstein's Evidence, § 1004(1)[05] at 1004-16.

The parties in this case agree that the central inquiry is whether plaintiff's original artwork depicting the AO785/2 and AO34E existed in 1979 and earlier and was principally destroyed by water damage, or whether, as defendants contend, the originals were created following plaintiff's access to materials utilized in the creation of ESB and have been intentionally withheld or destroyed in order to facilitate the admission of secondary evidence.

Plaintiff characterized this inquiry as a jury question, and as such, inappropriate for this Court to decide as a preliminary matter. Plaintiff reasons that the Court must focus solely on the time period particularly in issue here, that period of time preceding plaintiff's access to ESB materials; the question then becomes whether the AO785/2 and AO34E ever existed during that time period. Plaintiff argues that this puts the issue squarely within Rule 1008's allocation of such questions to the jury.

Defendants, on the other hand, contend that the originals did exist at some time (an inescapable conclusion given the second and third generation copies sought to be offered by plaintiff), but that the originals were created following plaintiff's access to ESB materials, and have been intentionally withheld or destroyed to conceal the true date of their creation. Therefore, defendants characterize the issue as not whether the originals ever existed, but whether the originals have been lost or destroyed in bad faith, a proper preliminary determination for the Court under Rules 104(a), 1004, and 1008.

The Court finds defendants' characterization to be the correct one. First, the originals must have existed at some time so that plaintiff could create the copies he seeks to offer into evidence. This is clearly not a case in which plaintiff is seeking to offer secondary evidence in the form of oral testimony and the like,[6] in

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[6] Rule 1004 states no preference for any particular type of secondary evidence to prove the content of sufficiently accounted for missing originals.

which case a true question as to the existence of the original may be posed. Rather, defendants' contention is that the originals existed and were destroyed in bad faith, or still exist and are being intentionally withheld.

Second, whether the originals were created prior to plaintiff's access to ESB materials or following that access is of little consequence when considered in light of the purpose of the "best evidence" rule. Although the "best evidence" rule is designed to facilitate the use of secondary evidence when there is a need to allow that evidence to be used in lieu of the original, the rule is also designed to keep out secondary evidence when its admission would be contrary to the furtherance of justice. A copy is always liable to error, whereas this contingency wholly disappears when the original is produced. 4 Wigmore on Evidence, § 1179 at 417. The copy may lack such features of handwriting, paper, and the like, contained in the original, and as such, deprive the opponent of the document or the trier of fact valuable means of learning legitimate objections to the significance of the document. *Id.* Rule 1004's purpose of making inadmissible secondary evidence of the content of originals which have been withheld or destroyed in bad faith should not be circumvented by plaintiff's restrictive reading of that Rule.

In sum, the Court finds that Rule 1004 is properly applied to this case and that plaintiff must establish the foundational requirements under that Rule by showing to the satisfaction of the Court that the originals for the AO785/2 and AO34E were lost or destroyed without bad faith.

B. Plaintiff Must Prove that the Originals Were "More Probably than Not" Lost or Destroyed Without Bad Faith.

It is clear that the sufficiency of the preliminary proof is addressed to the discretion of the trial judge. *See* 5 Weinstein, *supra*, § 1008[04] at 1008-12; *Willhoit v. C.I.R.*, 308 F.2d 259, 265 (9th Cir. 1962); *Development Corp. of America v. United Bonding Insurance Co.*, 413 F.2d 823, 825 (5th Cir. 1969). The trial judge's determination as to the standard of proof applicable will not be disturbed in the absence of clear evidence of mistake

amounting to an error of law. *Willhoit, supra,* 308 F.2d at 265; *see also, United States v. Gerhart,* 538 F.2d 807, 810 (8th Cir. 1976).

Plaintiff argues that the proper standard to apply is that "whenever there is doubt, discretion is best exercised by admitting the evidence" and leaving it to the jury to evaluate the excuse for nonproduction (citing 5 Weinstein, *supra,* § 1004(01)[05] at 1004-18). Several cases, however, indicate that a stricter standard should be applied when the particular facts and circumstances warrant such an application. *See, e.g., Sylvania Electric Products, Inc. v. Flanagan,* 352 F.2d 1005 (1st Cir. 1965); *Willhoit, supra,* 308 F.2d at 265. Where the missing original documents in dispute are the "very foundation of the claim," for example, more strictness in proof is required than where the writings are only involved collaterally. *Sylvania, supra,* 352 F.2d at 1008. Moreover, where any suspicion hangs over the true content of the instrument, or that it may be designedly withheld, a "more rigid" inquiry should be made into the reasons for its nonproduction. *Willhoit, supra,* 308 F.2d at 265; *see also* 4 Wigmore, *supra,* § 1194 at 439. ("[T]he moment the destruction becomes questionable at all, the inquiry is raised * * *.")

Under the particular facts and circumstances of this case, the Court declines to apply such a lenient standard as that advocated by plaintiff. Rather the proper standard to be applied by the Court in assessing whether or not plaintiff has satisfied the preliminary requirements of Rule 1004 is the "more probable than not" standard. Although there is some case authority for application of an even more stringent standard, under which the proponent of the evidence would have to show that there is "no reasonable probability" that the originals has been designedly withheld or suppressed,[7] this Court finds the "more probable than not" standard advocated by defendants and Judge Weinstein sufficient to vindicate the best evidence policy. *See* 5 Weinstein, *supra,* § 1008[04] at 1008-14.

First, the peculiar and suspicious circumstances surrounding the "discovery" and production of much of the secondary evi-

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[7] *Von Brimer v. Whirlpool Corp.,* 362 F.Supp. 1182, 1187 (N.D. Cal. 1973), *aff'd* 536 F.2d 838 (9th Cir. 1976).

dence in this case requires a "rigid inquiry." Second, the documents in issue here are the "very foundation" of plaintiff's claim, a claim in which plaintiff seeks to have a jury compare the similarities between plaintiff's work and defendants' work, and find the two to be "substantially" or even "strikingly" similar.[8] In making such a comparison, the importance of allowing a jury to view the plaintiff's originals for color, size, shading, line, and the like, rather than recreated, cut-and-paste, or third and fourth generation copies of those originals, is clear.

Accordingly, the applicable standard to be applied is that of "more probable than not." Under such a standard, the Court must find as a preliminary matter that it is "more probable than not" that the originals of the AO785/2 and AO34E were lost or destroyed without bad faith.

C. This Court has Discretion to Determine Whether The Proof Meets the Relevant Standard.

The determination of the sufficiency of the search, and in general, of the proof of the fact of loss is within the trial court's discretion, 4 Wigmore, *supra*, § 1194 and 442; *see also*, 5 Weinstein, *supra*, § 1008[04] at 1008-12. ("The court determines the standard * * * and whether the facts as it finds them show the standard was met.")

D. Plaintiff Has Not Established that the Originals Were Destroyed or Lost Without Bad Faith.

Based upon the court's findings of fact set forth above, the Court finds that plaintiff has not established, more probably than not, that any originals existing in 1979 and earlier were destroyed by water damage at the Boonville dome house, or were otherwise lost or destroyed without bad faith. The Court also finds, based upon the Court's findings of fact set forth above, that plaintiff has not established to the requisite degree that the original drawings existing after 1979 were destroyed or lost without bad faith.

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[8] In a copyright action, copying is proved by substantial similarity coupled with access. *See* 3 Nimmer, Nimmer on Copyright § 13.01[B].

Therefore, plaintiff has failed to satisfy the foundational requirements of Rule 1004 for admission of secondary evidence.

E. This Court Properly Considered All Evidence in Making its Determination.

Rule 104(a) expressly provides that in making preliminary determinations, a court is not bound by the rules of Evidence except those with respect to privileges. Fed. R. Evid. 104(a). Although Rule 104(a) is not an "open invitation" to ignore the Rules of Evidence, Rule 104(a) recognizes the ability of the court to receive all relevant evidence and to discount that evidence that is inherently untrustworthy or suspicious. *See* 1 Weinstein, *supra*, § 104[2] at 104-22-23 (trial judge's legal training and experience can be relied upon to winnow the "chaff from the wheat"). Therefore, under Rule 104(a), this Court was properly empowered to consider all relevant evidence in making its determination, without adhering strictly to the Rules of Evidence regarding hearsay and the like.

F. Secondary Evidence of the Content of the Originals is Inadmissible.

Under Rule 1004, secondary evidence is admissible to prove the contents of the missing originals if the preliminary requirements of Rule 1004 are met. Additionally, Federal Rule of Evidence 901(a) requires all evidence to possess a requisite degree of authenticity in order to support a finding that the evidence in question is what the proponent of such evidence claims it to be. Fed. R. Evid. 901(a). As this Court has found that plaintiff has not satisfied the preliminary requirements of Rule 1004, and that much of the secondary evidence plaintiff wishes to introduce lacks the requisite authenticity to justify its admission, all secondary evidence sought to prove the contents of the missing originals is inadmissible.

The foregoing constitutes the Court's findings of fact and conclusions of law. On or before October 26, 1984, counsel will file certificates of counsel setting forth the next steps to be taken in the case.

Dated: October 16, 1984.

WILLIAM H. ORRICK, JR.
William H. Orrick, Jr.
United States District Judge

Appendix D

United States District Court
Northern District of California

No. C-83-0696 WHO

Lee M. Seiler,
Plaintiff,

vs.

Lucasfilm, Ltd., Twentieth Century-Fox Film Corporation, George W. Lucas, Jr., and Joseph E. Johnson,
Defendants.

and Related Case
Nos. C-83-1244 WHO and C-83-3970 WHO

MEMORANDUM AND ORDER

[Filed March 13, 1985]

In these copyright infringement cases, plaintiff claims that defendants, creators and producers of the movies "The Empire Strikes Back" and "Return of the Jedi," and commercial licensees copied some of plaintiff's work for use in the films and on various products. Plaintiff possesses no originals of any of the works he contends were copied by defendants, and seeks to introduce secondary evidence in the form of copies reconstructions, projections, and the like in lieu of the originals in order to establish the content of the missing originals. All three cases were related for purposes of discovery. The Court later ordered that C-83-0696 WHO would be the first case to be tried.

Upon the motion of both parties, the Court held an evidentiary hearing in C-83-0696 WHO to determine the preliminary question of whether the originals were lost or destroyed in bad faith. *See* Federal Rule of Evidence 1004(1). The Court listened to seven days of testimony, and viewed in excess of one hundred documentary exhibits. On October 16, 1984, the Court made detailed findings of fact and conclusions of law, and ruled that plaintiff failed to meet the even minimal showing required under Federal Rule of Evidence 1004 to justify admission of secondary evidence to prove the contents of the missing originals. Addition-

ally, the Court found that much of the secondary evidence plaintiff seeks to offer lacks the requisite degree of authenticity to justify its admission under Federal Rule of Evidence 901(a). Consequently, the Court held that "all secondary evidence offered to prove the contents of the missing originals is inadmissible. Opinion at 2.

Defendants have now moved for summary judgment in all three cases on the obvious ground that, without evidence of the existence of a copyrighted work, plaintiff cannot possibly prevail at trial. While this Court is persuaded that summary judgment in C-83-0696 WHO is inescapable given the court's Opinion of October 16, several of plaintiff's arguments in opposition to summary judgment must be briefly addressed.

First, plaintiff argues that this Court's Opinion of October 16 barring all secondary evidence offered to prove the contents of the missing originals, does not apply to testimonial evidence, or to those works that are originals in themselves. This court disagrees.

The Opinion of October 16 expressly states that *all* secondary evidence is inadmissible. The Federal Rules of Evidence do not distinguish between internal "degrees" of secondary evidence. *See* Notes to Advisory Committee on Proposed Rules, Rule 1004. Therefore testimonial evidence, for example, is secondary evidence to the same degree as is evidence consisting of reconstructions or cut-and-pastes. More important, the policy to be effectuated by the Best Evidence rule is equally applicable to the type of evidence plaintiff wishes to except from the scope of the Rule as it is to reconstructions. The Best Evidence Rule is directed toward the prevention of fraud or inaccuracy. *See* 11 *Moore's Federal Practice* § 1002.02; 4 *Wigmore on Evidence* § 1179. The fact that the evidence offered to prove the content of the missing originals includes original depictions of other works, or is in the form of testimonial evidence, is irrelevant. The evidence is offered to prove the content of the missing originals. Under Federal Rule of Evidence 1004, such evidence is "secondary" and inadmissible if plaintiff cannot establish that the missing originals were lost or destroyed without bad faith.

Second, plaintiff argues for the first time in the course of these lengthy proceedings that the Best Evidence Rule is not applicable to his works. Plaintiff points to Rule 1004(1), which states that its proscriptions apply to a "writing, recording or photograph." Rule 1001(1) then defines "writings" as consisting of "letters, words, or numbers, or their equivalent" that have been set down by "handwriting, typewriting, printing, photostating, [or] photographing . . . ". Plaintiff's argument is that the works at issue in this suit are solely "drawings" and not letters, words, numbers, or their equivalent.

Plaintiff's characterization of his works at issue as solely "drawings" is inconsistent both with plaintiff's prior characterization of his works and also with the court's characterization. In plaintiff's complaint, for example, plaintiff describes three of his four registered works that remain in dispute as "original text and artworks embodied in a publication." First Amended Complaint at 3, 6, 10. Plaintiff's copyright registration applications were made on form "TX," which is the form designated for use of all literary works, not the form which is designated for use when registering pictorial or visual works. *See* 37 C.F.R. § 202.3(b)(1)(i) and (iii). All four of the disputed works contain both text and illustrations. Some contain numbers. Indeed, three of the works sued upon are plans, containing numerical specifications, text concerning the history and culture of the creatures depicted, and illustrations of the creatures. All have been set down by a combination of printing, photostating or other photographic process, as is required by Federal Rule of Evidence 1004(1).

Additionally, in a copyright case, the plaintiff must attempt to convince a jury that the defendant's works are substantially, or even strikingly, similar to plaintiff's own works. The necessity for the original or for an accurate copy cannot be overstated. For this reason as well, this Court finds that the Best Evidence Rule is applicable to the works at issue.

Finally, plaintiff argues that his copyright applications, and particularly the registration and deposit copies attached to those registrations, must be admitted regardless of the Court's determination on the Best Evidence question. While the copyright statute

at issue, 17 U.S.C. § 410(c), and this Court's July 17, 1984, ruling requires the Court to give *prima facie* effect to plaintiff's copyright registrations, the presumption created is rebuttable. *See* 3 M. Nimmer, *Nimmer on Copyright* § 12.11. Courts have granted summary judgment in cases involving 17 U.S.C. § 410(c) where the evidence in the record casts doubt upon the validity of the facts contained in the copyright registration. *See, e.g., Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980). *See also United States v. Taxe*, 540 F.2d 961, 966 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040, *reh'g denied*, 429 U.S. 1124 (suggesting that a concrete showing of lack of trustworthiness would justify not admitting copyright registrations otherwise qualifying as *prima facie* evidence).

In this case, plaintiff has admitted that the copyright registration applications, including the deposit copies, are not originals, but rather "reconstructions". As the Court's Opinion of October 16 discusses at length, the record in this case casts serious doubt upon the validity of the contents of the copyright registrations. For that reason, the copyright registrations are subject to the Court's Best Evidence ruling.

On October 16, 1983, this Court ruled that all secondary evidence offered to prove the contents of the missing originals is inadmissible. Plaintiff possesses no originals; therefore, all of plaintiff's proffered evidence is secondary evidence offered to prove the content of the missing originals. Without evidence of the existence of a copyrighted work, plaintiff cannot prevail at trial. Defendants' motion for summary judgment must be granted.

IT IS HEREBY ORDERED that:

1. Defendants' motion for summary judgment in C-83-0696 WHO is GRANTED;

2. Defendant's motion for summary judgment in related cases C-83-1244 WHO and C-83-3970 WHO is SUBMITTED;

3. Defendants shall submit a form of judgment on or before March 22, 1985.

Dated: March 12, 1985.

WILLIAM H. ORRICK, JR.
William H. Orrick, Jr.
United States District Judge

Appendix E

United States Court of Appeals
For the Ninth Circuit

CA No. 85-1955

DC No. CV-83-696-WHO
(Northern California)

Lee M. Seiler,
Plaintiff-Appellant,

vs.

Lucasfilm, Ltd., Industrial Light and Magic,
Twentieth Century-Fox
Film Corporation, George Lucas, Jr., and
Joseph E. Johnston,
Defendants-Appellees.

ORDER

[Filed Feb. 17, 1985]

Before: FARRIS, and BOOCHEVER, Circuit Judges, and KEEP,*
District Judge.

The panel as constituted in the above case has voted to deny the petition for rehearing. Judge Farris has voted to reject the suggestion for a rehearing en banc and Judges Boochever and Keep recommend rejection.

The full court has been advised of the suggestion for an en banc hearing, and no judge of the court has requested a vote on it. Fed. R. App. P. 35(b).

The petition for rehearing is denied and the suggestion for a rehearing en banc is rejected.

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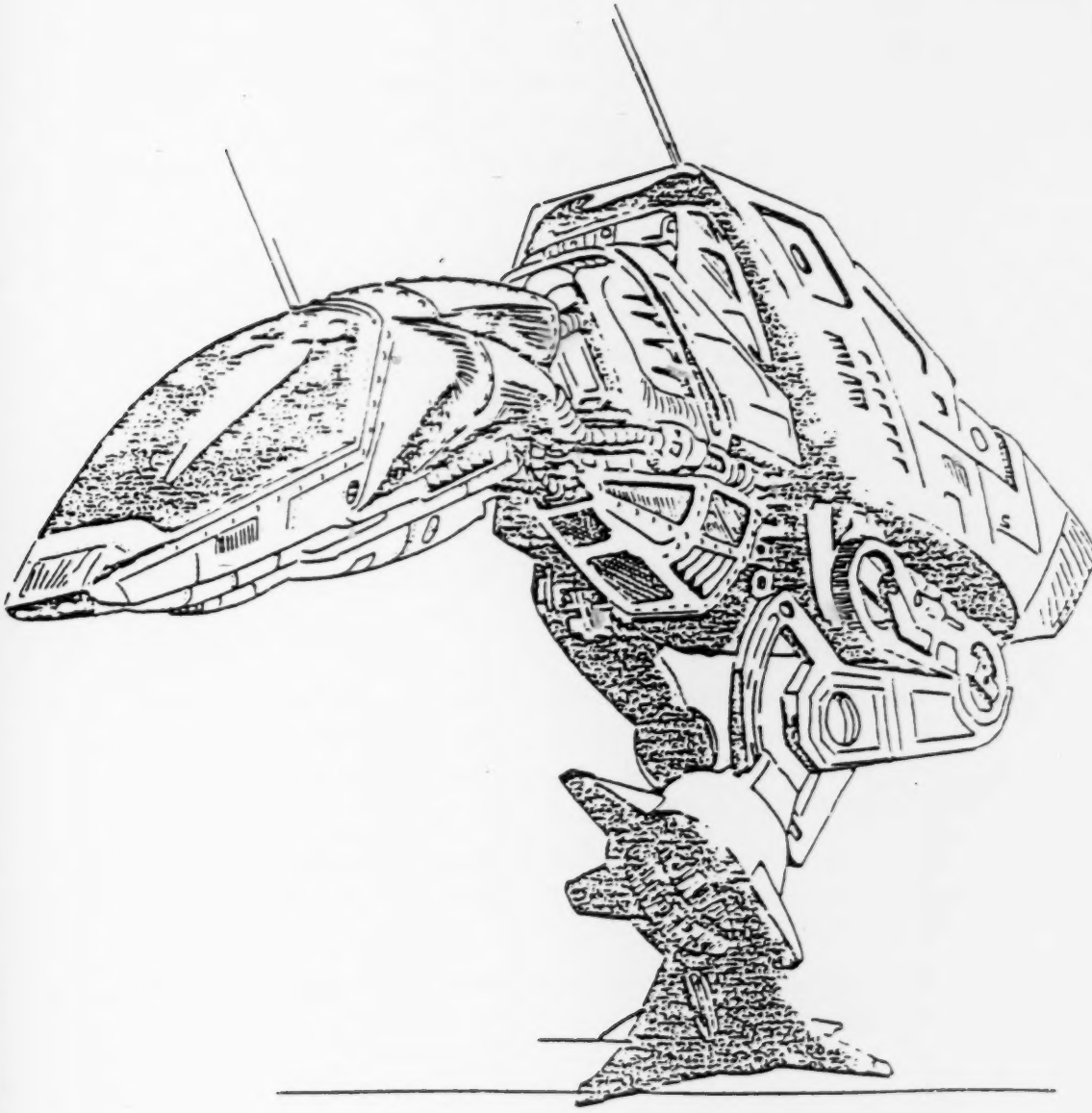
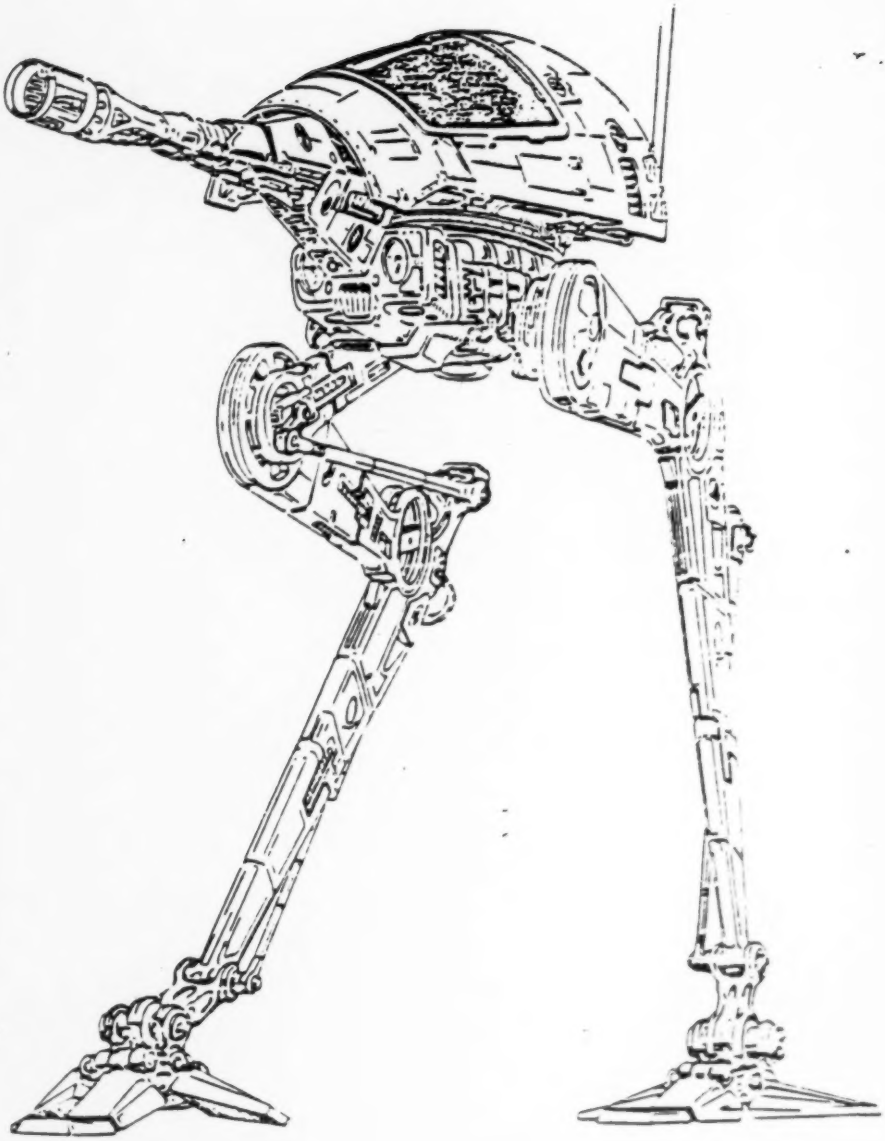
* The Honorable Judith N. Keep, United States District Judge for the Southern District of California, sitting by designation.

Appendix F



"THE WALKER" AO-34
GARTHIAN WALKER



"THE SPRINTER" AO-785/2

EXHIBIT"D"

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Supreme Court, U.S.
FILED
JUL 13 1987
JOSEPH F. SPANIOL, JR.
CLERK

No. 86-1965

In the Supreme Court

OF THE

United States

OCTOBER TERM, 1986

LEE M. SEILER,
Petitioner,
VS.
LUCASFILM, LTD., TWENTIETH CENTURY-FOX FILM CORPORATION,
GEORGE W. LUCAS, JR. and JOSEPH E. JOHNSTON,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE NINTH CIRCUIT COURT OF APPEALS

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DESIGNATION OF CORPORATE RELATIONSHIPS

Lucasfilm, Ltd., filing this Brief in Opposition To Petition for *Writ of Certiorari* To The Ninth Circuit Court of Appeals as a respondent in this proceeding, states that:

This is its original Designation of Corporate Relationships.

Lucasfilm, Ltd. is not owned by any parent corporation.

Lucasfilm, Ltd. does not have an ownership interest in any subsidiaries (excepting only wholly-owned subsidiaries).

Lucasfilm, Ltd. does not have any affiliates.

Twentieth Century Fox Film Corporation, filing this Brief In Opposition To Petition For *Writ of Certiorari* To The Ninth Circuit Court Of Appeals as a respondent in this proceeding, states that:

This is its original Designation of Corporate Relationships.

TCF Holdings, Inc. is the parent of Twentieth Century Fox Film Corporation.

Twentieth Century Fox Film Corporation does not have an ownership interest in any subsidiaries (excepting only wholly-owned subsidiaries).

Twentieth Century Fox Film Corporation does not have any affiliates.

Dated: June 29, 1987

TABLE OF CONTENTS

	Page
TABLE OF AUTHORITIES	ii
I	
INTRODUCTION	1
II	
STATEMENT OF THE CASE	3
III	
THE APPLICATION OF FEDERAL RULE OF EVIDENCE 1004 TO THE FACTS OF THIS CASE BY THE DISTRICT AND CIRCUIT COURTS CREATES NO CONFLICT WITH ANY OTHER FEDERAL OR STATE COURT OPINION NOR DOES IT RESULT IN ANY ABROGATION OF SEVENTH AMENDMENT RIGHTS	7
IV	
THE CIRCUIT COURT'S INTERPRETATION OF FEDERAL RULE OF EVIDENCE 1001 NEEDS NO REVIEW BY THIS COURT IN THE CONTEXT OF THIS COPYRIGHT CASE BECAUSE IT WAS PERMISSIBLE AND SOUND, CONSISTENT WITH RELEVANT POLICY CONSIDERATIONS AND APPROPRIATELY NARROW	10
V	
THE COPYRIGHT ACT DOES NOT GUARANTEE A JURY TRIAL TO EVERY COPYRIGHT REGISTRANT; MOREOVER THIS CASE PRESENTS SUCH A UNIQUE FACT PATTERN THAT ANY PRECEDENTIAL EFFECT IS LIKELY TO BE NIL	14
CONCLUSION	17
APPENDIX A. Relevant Excerpts From the Record	A-1
APPENDIX B. Court's Order of February 19, 1987	B-1

TABLE OF AUTHORITIES

Cases

Page

Carol Barnhart, Inc., v. Economy Cover Corp., 594 F.Supp. 364 (E.D.N.Y. 1984) *rehearing denied*, 603 F.Supp. 432 (1985); *affirmed* 773 F.2d 411 (2d Cir. 1985) 14, 15

Gila Valley Railroad Company v. Hall, 232 U.S. 94 (1913) 10

National Labor Relations Board v. Pittsburgh Steamship Co., 340 U.S. 498 (1951) 2

Sylvania Electric Products, Inc. v. Flanagan, 352 F.2d 1005 (1st Cir. 1965) 9

Willhoit v. C.I.R., 308 F.2d 259 (9th Cir. 1962) 9

Constitution

United States Constitution, Seventh Amendment 5, 6, 7, 10, 17

Federal Rules

Federal Rules of Evidence, Rule 104 ..... 3, 6, 7, 10

Federal Rules of Evidence, Rule 1001 ..... 10, 11, 12, 13

Federal Rules of Evidence, Rule 1004 .... 3, 5, 6, 7, 9, 16

Federal Rules of Evidence, Rule 1008 ..... 7, 8, 9

Other

Copyright Act, Sec. 410(c) 15

House Report No. 93-650 13

Rules of Supreme Court, Rule 17 ..... 1, 5, 13

No. 86-1965

In the Supreme Court

OF THE

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OCTOBER TERM, 1986

LEE M. SEILER,
Petitioner,
VS.

LUCASFILM, LTD., TWENTIETH CENTURY-FOX FILM CORPORATION,
GEORGE W. LUCAS, JR. and JOSEPH E. JOHNSTON,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE NINTH CIRCUIT COURT OF APPEALS

I

INTRODUCTION

This case is uniquely inappropriate for review by this Court. Indeed, it is fairly labeled *sui generis*. None of the considerations enunciated in Rule 17, which govern review on *certiorari*, is implicated here. This case does not present an issue of general public importance nor has the opinion of the Ninth Circuit created a lack of uniformity of decision among the circuit courts on any issue of federal law.

As this Court has often noted, the single most important reason for granting a petition for *certiorari* is when the issue sought to be reviewed involves a conflict of decisions among the lower federal courts on a point of federal law, the rationale being to achieve a uniform application of federal law in the intermediate federal court system. Even so, this Court has not been inclined to grant *certiorari* to resolve a conflict in appellate courts over an issue that is unlikely to recur. Thus even where a conflict exists *certiorari* is often denied when it seems likely that the impact of the conflict is narrowly confined and not apt to have continuing future circumstances. This is particularly true when the case presents a unique factual situation.

The petitioner in this case has now manipulated the court system for almost five years, oppressing the unblemished lives of serious creative artists who have been found by two levels of federal courts to be totally without liability to petitioner. Granting a disgruntled plaintiff yet a third forum in which to publish his slanderous allegations of plagiarism is not a proper function of a writ of *certiorari*.

As this Court held in *National Labor Relations Board v. Pittsburgh Steamship Co.*, 340 U.S. 498, 503 (1951):

> "It is not for us to invite review by this Court of decisions turning solely on evaluation of testimony. . . . In such situations we should adhere to the usual rule of non-interference where conclusions of circuit courts of appeals depend on appreciation of circumstances which admit different interpretations."

Petitioner's effort to fashion legal issues of sufficient significance for this Court's consideration from express and unchallenged findings of petitioner's "bad faith,"

"false testimony," "fabrications," and "misrepresentations" must be rejected.

II

STATEMENT OF THE CASE

Petitioner's formulations of the "questions presented" by this case are inaccurate because they misrepresent the proceedings below or misstate the questions actually presented to and ruled upon by the circuit court. Respondents will briefly review some salient facts of this case because of additional inaccuracies and misleading statements in the petition for *writ of certiorari*.

First, the district court did *not* "conduct a seven-day bench trial on the central issue of the case." The district court conducted an appropriate evidentiary hearing requested, indeed demanded, *by petitioner*, pursuant to Federal Rules of Evidence ("F.R.E.") 104 and 1004. In fact, the evidentiary hearing had simple origins. Petitioner wished to show "blow-up" comparisons of his works and defendants' works to the jury during opening statement. The district court operated under a rule which disallowed exposure to the jury of any materials until they had been admitted in evidence. This was a longstanding policy of the court which was not specifically imposed for the purposes of this action. [E.R. 487.][1] Petitioner's counsel insisted that the court make evidentiary rulings prior to opening statements because he felt he could not make his opening statement without showing petitioner's reconstructions to the jury. Counsel for petitioner stated:

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[1]Relevant excerpts from the record including the Reporter's Transcript are reproduced as Appendix A.

> "[I]f they're going to keep coming up, and if we're going to have to deal with them throughout the course of the trial, we'd better deal with them first." [E.R. 705-706; R.T. 6-7.]

In requesting evidentiary rulings, petitioner's counsel did not put forward any of the legal arguments he later attempted to rely on in the circuit court and now wishes to renew before this Court. He never suggested that there would be any impropriety in holding a best evidence rule hearing, that a best evidence rule hearing on admissibility was inconsistent with the Copyright Laws, that the rule was inappropriately applied to petitioner's work in suit, or that, by deciding the admissibility of petitioner's secondary evidence, the district court would be usurping the jury's function. The results of the evidentiary hearing were, quite simply, a finding that petitioner was a liar and that he could not establish the crucial link between the reconstructions he fraudulently deposited with the Copyright Office and his allegedly pre-existing originals — of which he had none.[2]

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[2]The district court's findings in this case, which the circuit court found were amply supported by the record, are based on strange — even bizarre — facts unlikely to be repeated in the future. In summarizing the 7 days of testimony elicited from 14 witnesses and careful consideration of over 100 exhibits, the court found that "Plaintiff testified falsely as to the destruction of [his] original artwork . . . in a 1979 "flood" underneath his Boonville dome house. Plaintiff purposefully destroyed or withheld in bad faith [his] original artwork. . . . Plaintiff fabricated and misrepresented the nature of secondary evidence for use in this lawsuit." 613 F.Supp. at 1259-60. The court found that plaintiff falsely created a videotape to bolster his misrepresentations and purposefully misrepresented the date of the tape's creation. The Court found plaintiff's testimony (and the testimony of his wife and best friend) "inherently and overwhelmingly unbelievable," "often bordering on the incredible." 613 F.Supp. at 1254, 1255.

The issue presented to the district court and to the circuit court was *never* whether plaintiff's asserted original works "ever existed," but rather whether the originals had been destroyed or withheld in bad faith. This question was clearly for the court pursuant to F.R.E. 1004. It is only by misstating the nature of respondents' best evidence objection that petitioner can argue that the wrong rule was applied.

Petitioner's disingenuous assertions, designed to alarm the circuit court, and now this Court, by raising the specter of vitiation of Seventh Amendment protections, are unavailing. More important, petitioner's characterizations of the circuit court's opinion are simply inaccurate. Petitioner's effort to clothe his well-documented fraud in a cloak of legal principle is understandable. But the truth is that this case presented a unique *factual* situation created by petitioner's bold abuse of the Copyright Office and the courts. Based on the unusual facts before it, the opinion of the circuit court was appropriately narrow and the reach of this case should prove concomitantly restricted. For this reason, alone, there is no question of law that justifies the grant of a *writ of certiorari* here.[3]

Petitioner has wholly failed to sustain his burden of establishing under Rule 17 that there are special and important reasons why the writ should be granted. The decision below did not involve an important question of federal law which has not been, but should be, settled by this Court; nor has the Ninth Circuit decided a federal question in a way to conflict with applicable decisions of

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[3]The circuit court recognized the narrow and uncontroversial impact of its opinion in denying petitioner's motion for rehearing and rejecting the suggestion for a rehearing *en banc*. The Court's Order of February 19, 1987 is reproduced as Appendix B.

this Court or of another Court of Appeals in the same matter.

With unwarranted melodrama petitioner ominously warns that the circuit court has "blazed" a path for "turning the Seventh Amendment into an "impotent exhortation." [Petition at p. 9.] Elsewhere, petitioner bemoans the absence of any discussion of the Seventh Amendment in the circuit court's opinion, conveniently ignoring the obvious reason for that absence: the case presents no Seventh Amendment issue. The circuit court quite properly, and traditionally, applied the Federal Rules of Evidence (F.R.E. 104 and F.R.E. 1004) in precisely the manner envisioned by the drafters of those rules, who clearly did not intend to oust the trial judge of his time-honored and necessary role of ruling on preliminary questions of fact affecting admissibility.

While truly it can be said with justification that each case is unique, this case must be labelled (albeit ungrammatically) "more unique" than most. Petitioner presented himself as the author of a once-existing, once-published work whose *only* "exemplar" was a reconstruction deposited with the Copyright Office years after it was allegedly created, and, most important, *after* the allegedly infringing work of defendant was exhibited.

Little wonder that petitioner sought in the district and circuit courts to invest his unique deposit copy with such enormous legal and evidentiary significance. Petitioner's fraudulently obtained copyright certificate was a predicate for suit, but he sued on a work that he does not have and that does not now exist and his "planted," after-the-fact reconstructions were properly rejected by both the district court and the circuit court as an improper foundation for a copyright infringement action. Disallowing their use for that purpose can, by no stretch of the

imagination, be deemed a distortion or violation of the Copyright Act, the Federal Rules of Evidence or the Seventh Amendment.

III

THE APPLICATION OF FEDERAL RULE OF EVIDENCE 1004 TO THE FACTS OF THIS CASE BY THE DISTRICT AND CIRCUIT COURTS CREATES NO CONFLICT WITH ANY OTHER FEDERAL OR STATE COURT OPINION NOR DOES IT RESULT IN ANY ABROGATION OF SEVENTH AMENDMENT RIGHTS

Petitioner admitted in his petition for rehearing, after the circuit court issued its opinion, that the "court/jury allocation issue was extensively briefed in [the circuit] court, and further developed at the oral argument." Thus, contrary to the argument he now makes to this Court, the circuit court was well aware of, and squarely confronted, the issue of petitioner's jury entitlement, *vel non*, in this case. The circuit court held that F.R.E. 1004 was applicable to this case, not, as petitioner continues to insist, F.R.E. 1008. The circuit court specifically adverted to F.R.E. 1008 in the context of criticizing petitioner's argument that it, rather than F.R.E. 1004, was the applicable rule.

F.R.E. 1008 creates an exception to the rule that questions of admissibility are ordinarily for the court to determine in accordance with the provisions of F.R.E. 104. That exception comes into play when an issue is raised:

> "(a) whether the asserted writing ever existed, or (b) whether another writing, recording, or photograph produced at the trial is the original, or (c)

whether other evidence of contents correctly reflects the contents, . . ." [F.R.E. 1008.]

As the circuit court noted:

> "Lucas conceded the originals existed and Seiler conceded the items he sought to introduce were not the originals. Hence, as subsections (a) and (b) are not in issue, Seiler is arguing that 1008(c) requires that the case be submitted to the jury." 808 F.2d at 1321, fn. 2.

The opinion went on:

> "Seiler's position confuses admissibility of the reconstructions with the weight, if any, the trier of fact should give them, after the judge has ruled that they are admissible. Rule 1008 states, in essence, that when the *admissibility* of evidence other than the original depends upon the fulfillment of a condition of fact, the trial judge generally makes the determination of that condition of fact . . . In the instant case, *the condition of fact which Seiler needed to prove was that the originals were not lost or destroyed in bad faith.* Had he been able to prove this, his reconstructions would have been admissible and then their accuracy would have been a question for the jury. In sum, since admissibility of the reconstructions was dependent upon finding that the originals were not lost or destroyed in bad faith, the trial judge properly held the hearing to determine their admissibility." (Emphasis added.) 808 F.2d at 1321.

Concerning the specific condition of fact which petitioner needed to prove, the circuit court held that the district court's finding that "Seiler testified falsely, purposefully destroyed or withheld in bad faith the originals, and fabricated and misrepresented the nature of his

reconstructions" was "amply supported by the record." 808 F.2d at 1320.

Respondents did not, either at the district court or circuit court, argue that petitioner's original works did not exist. In fact, respondents contend that the originals did exist at some time, but that they were created after petitioner saw respondents' work and were intentionally withheld or destroyed to conceal the true date and manner of their creation. As the district court found, the fact that originals did exist at some time was "an inescapable conclusion given the second and third generation copies sought to be offered by plaintiff." [E.R. 517]. Where the existence of the originals is not at issue, but their bad faith loss or destruction is, both F.R.E. 1004 and 1008 provide that the determination of whether the proponent of the evidence has established that all the originals were lost or destroyed without bad faith, is a question for the court.

Contrary to petitioner's unsupported argument that where proffered secondary evidence relates to documents crucial to plaintiff's claim the court should abdicate its responsibility in favor of the jury, when the missing original documents in dispute are the "very foundation of the claim," more strictness in proof is required than where the writings are only involved collaterally. *Sylvania Electric Products, Inc. v. Flanagan*, 352 F.2d 1005, 1008 (1st Cir. 1965) ["[U]nder the Best Evidence Rule, in order to permit proof by secondary evidence of the allegedly lost or otherwise unavailable original writing, the trial judge must make preliminary findings that the original had become unavailable, otherwise than through the fault of the proponent of the testimony. . . ."]; *Willhoit v. C.I.R.*, 308 F.2d 259 (9th Cir. 1962).

Questions of admissibility of evidence have always been for the determination of the trial court judge. As this Court said in *Gila Valley Railroad Company v. Hall*, 232 U.S. 94 (1913):

> "This is so whether its admission depend upon matter of law or upon matter of fact. And the finding of the trial judge upon such a preliminary question of fact is not subject to be reversed on appeal for error if it be fairly supported by the evidence, as it is in the case before us [citations omitted]." 232 U.S. at 103.

In our system, the judge has always determined what witnesses and what evidence the jury shall hear. F.R.E. 104. If the only evidence that a plaintiff can marshall is inadmissible, he will have no viable action. Disallowing him to present inadmissible evidence to a jury does not abrogate any Seventh Amendment rights.

Petitioner's effort to alarm this Court at a potential pervasive impact of the circuit court's holding is mere rhetoric. The Federal Rules of Evidence clearly allocate certain decisions to the judge and others to the jury. The circuit court's opinion has no impact on that well-established allocation.

IV

THE CIRCUIT COURT'S INTERPRETATION OF FEDERAL RULE OF EVIDENCE 1001 NEEDS NO REVIEW BY THIS COURT IN THE CONTEXT OF THIS COPYRIGHT CASE BECAUSE IT WAS PERMISSIBLE AND SOUND, CONSISTENT WITH RELEVANT POLICY CONSIDERATIONS AND APPROPRIATELY NARROW

Although petitioner insists that the circuit court "ignored" Congressional intent when it interpreted F.R.E. 1001 to include petitioner's works in this case, once again

reference to the court's actual opinion establishes otherwise. [808 F.2d at 1318-1320.] Indeed, the court itself engaged in a substantial textual and historical analysis to support its holding that "Seiler's drawings were 'writings' within the meaning of Rule 1001(a)." [808 F.2d at 1318-19.] The court quotes from the advisory committee notes which point out that the rule is "essentially" — *not exclusively* — related to writings.

In the petition, immediately after discussing the advisory committee's notes and referring to them, there is a quotation which refers to the advisory committee and presumes to divine a "deliberate choice" of the committee with respect to expansion of the definition. However, petitioner's quote is *not* from the advisory committee's notes; it is from an evidence treatise which, as the circuit court pointed out, "seems more historical than rigorously analytic," and renders an opinion "without support from any cases that the rule is limited to words and figures." [808 F.2d 1318.] There are, in fact, no such cases.

As the circuit court also noted, the copyright laws give legal protection to the objective manifestations of the creative mind, just as the law of contracts protects other legally cognizable rights. The essence of an infringement action implicates proof of the substantial similarity between the plaintiff's work and the defendant's.

> "There can be no proof of 'substantial similarity' and thus of copyright infringement unless Seiler's works are juxtaposed with Lucas' and their contents compared. Since the contents are material and must be proved, Seiler must either produce the original or show that it is unavailable through no fault of his own. Rule 1004(1). This he could not do.

> "The facts of this case implicate the very concerns that justify the best evidence rule. . . . In short, Seiler claims that the movie infringed his originals, yet he has no proof of those originals.
>
> "The dangers of fraud in this situation are clear. The rule would ensure that proof of the infringement claim consists of the works alleged to be infringed. Otherwise, 'reconstructions' which might have no resemblance to the purported original would suffice as proof for infringement of the original. Furthermore, application of the rule here defers to the rule's special concern for the contents of writings. Seiler's claim depends on the content of the originals, and the rule would exclude reconstituted proof of the originals' content. Under the circumstances here, no "reconstruction" can substitute for the original." 808 F.2d at 1319.

Additionally, petitioner's works included many words and numbers and were created by photographic and reprographic techniques. Indeed, petitioner's works are an example of the "modern developments" envisioned by the drafters of the rule. Although one focus of the case was, as the circuit court observed, on "drawings," they were merely *part* of the works at issue allegedly copyrighted by petitioner who did not in his applications to the Copyright Office describe them as "artworks." None is simply a drawing and each was created by photography and substantially comprised of words and numbers.

The circuit court, properly interpreting F.R.E. 1001 held:

> "A creative literary work, which is artwork, and a photograph whose contents are sought to be proved, as in copyright, defamation, or invasion of privacy,

> are both covered by the best evidence rule. See *McCormick,* § 232 at 706 n. 9; Advisory Committee's Note to Rule 1002; 5 Louisell & Mueller, § 550 at 285 n. 27. We would be inconsistent to apply the rule to artwork which is literary or photographic but not to artwork of other forms. Furthermore, blueprints, engineering drawings, architectural designs may all lack words or numbers yet still be capable of copyright and susceptible to fraudulent alteration. In short, Seiler's argument would have us restrict the definitions of Rule 1001(1) to 'words' and 'numbers' but ignore 'or their equivalent.' We will not do so in the circumstances of this case." 808 F.2d at 1320.

Not only is the circuit court's interpretation warranted in light of the policy issues which underlie F.R.E. 1001 (petitioner cannot and does not suggest any policy reason to exclude his type of work from the operation of the rule), but the most recent developments presage that its holding would be endorsed by other circuit courts. In House Report No. 93-650, the committee on the judiciary amended F.R.E. 1001 expressly to include "video tapes" in the definition of "photographs." Since video tapes as a rule are comprised of, or at least include, visual images, as well as words and numbers, the sterile distinction urged by petitioner (without any case or policy support) appears unlikely to find favor. Most important, for the purposes of petitioner's *writ of certiorari,* none of the Rule 17 criteria is met with respect to this issue at this time.

V

THE COPYRIGHT ACT DOES NOT GUARANTEE A JURY TRIAL TO EVERY COPYRIGHT REGISTRANT; MOREOVER THIS CASE PRESENTS SUCH A UNIQUE FACT PATTERN THAT ANY PRECEDENTIAL EFFECT IS LIKELY TO BE NIL

The most cursory review of the facts of this case will serve to convince this Court that it is highly improbable that a case like this one will be repeated or that the circuit court opinion resolving it will have wide — if indeed any — future applicability. Rare indeed is (or will be) the copyright case in which a plaintiff does not have a copy of his work. The reason that the parties to this action were unable to uncover a single copyright opinion discussing the best evidence rule does not mean, as petitioner would contend, that the rule has no applicability in copyright cases. Rather, it is that the overwhelming majority of plaintiffs who come into court on a copyright claim have a copy of their work as published with proper notice, can point to the existence of that work in the hands of independent witnesses, and can establish by admissible evidence the publication with notice of their work prior to, *and before their own access to,* the defendant's allegedly infringing work. None of those foundational elements was present in this case. The best explanation for why there are no cases elucidating the issue raised by petitioner is that few plaintiffs would be so emboldened as to tread such a perilous path.

Nothing in § 410 of the Copyright Act compels a jury trial in a setting such as is presented by this action. Even where the presumptions afforded by the Copyright Act are available to an infringement plaintiff, evidence to rebut the presumptions can be offered by defendants to the court. *See, e.g. Carol Barnhart, Inc. v. Economy Cover*

Corp., 594 F.Supp. 364 (E.D.N.Y. 1984) *rehearing denied*, 603 F.Supp. 432 (1985); *affirmed* 773 F.2d 411 (2d Cir. 1985). Although petitioner purports to divine a "deliberate policy choice" in § 410(c) that copyright certificates must at least reach the trier of fact, such divination appears to have no basis in the statute itself, in the history of the statute or in the case law. Indeed, such a suggestion would make summary judgment unavailable to a defendant in a copyright action. It is apparent that, however generous the presumptions afforded a copyright plaintiff by the Copyright Act, it was not designed to encourage and facilitate fraud. As the circuit court pointed out:

> "The Copyright Act does not contemplate the copyrighting of a non-existent original on the basis of a tendered reconstruction. Section 408 specifies the types of material that must be deposited along with an application for a certificate. The permissible materials include bona fide copies of the original work only; there is no mention of 'reconstructions.' If it were otherwise, the possibilities for fraud would be limitless." 808 F.2d at 1322.

Further, § 410(c) merely provides that the certificate of registration shall constitute *prima facie* evidence of the validity of facts stated in the copyright certificate. When, as here, a reconstruction was attached to the certificate, it was no abuse of the court's discretion to conduct a pretrial hearing which resulted in the finding that petitioner had lost or destroyed the originals in bad faith. That finding overcomes any presumption afforded the attachment to the certificate by virtue of § 410(c).

Of central significance, as the circuit court observed, was the fact that neither the certificates nor their attachment purported to speak on the ultimate issue of whether

the reconstructions were true to the supposed originals. That question was preliminary and for the court pursuant to F.R.E. 1004. "Prima facie evidence of statements in the certificate" were "irrelevant until that proof had been made." [808 F.2d at 1322.]

While admittedly petitioner in this case sought to make novel (and perhaps unprecedented) use of the Copyright Act, the circuit court's appropriately narrow holding is neither novel, radical, nor likely to be of widespread precedential application. It neither threatens fundamental rights nor does it find itself in disagreement with any published opinion of a circuit court of the land or of this Court.

CONCLUSION

Petitioner's description of this case as one affecting "ultimately every federal litigant entitled to invoke the Seventh Amendment," is ludicrous. It would be humorous were it not such a gross distortion of reality. The reality is that after years of effort and expense defendants have finally defeated a suit that was frivolous and fraudulent in the first place. The petition has no greater merit and should be denied.

DATED: July 10, 1987.

Respectfully submitted,

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BIRD, MARELLA, BOXER,
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Attorneys for Respondents Lucasfilm, Ltd., Twentieth Century Fox Film Corporation, George W. Lucas, Jr. and *Joseph E. Johnston*

APPENDIX A

EXCERPT FROM PLAINTIFF'S MEMORANDUM RE BEST EVIDENCE HEARING [E.R. 487]

10. In addition, on the basis of a purported Best Evidence objection by defendants, the Court ruled that plaintiff's counsel could not use any exhibits in opening statement. This ruling was made without an offer of proof by defendants, but based only on a claim that the documents had been fraudulently created. In spite of plaintiff's offer of proof in compliance with Fed.R.Evid. 1004, the Court sustained this objection.

11. On Tuesday morning, September 11, 1984, plaintiff's counsel moved for mistrial, based on many grounds, including the ruling precluding plaintiff's counsel from showing exhibits to the jury in opening statement. Plaintiff's counsel pointed out to the Court that this ruling had effectively eliminated plaintiff's ability to make an opening statement that would inform the jury of what was involved in the case, and effectively dictated to plaintiff the order in which he offered evidence.

12. Plaintiff's counsel argued that the Court should have demanded of defendants some offer of proof, and, if the Court had any questions based on the offer of proof, the Court should have ordered an evidentiary hearing to resolve the "Best Evidence" issue before the trial started.

13. The Court acquiesced and ordered a "Best Evidence" hearing to determine if the plaintiff should be permitted to use originals, duplicates and secondary evidence of the original depiction of his Walkers.

14. While a "Best Evidence Hearing" should address the issues set forth in Fed.R.Evid. 1004, it soon became apparent that defendants did not have a Best Evidence objection to the . . .

EXCERPT FROM TRANSCRIPT OF PROCEEDINGS OF SEPTEMBER 10, 1984 [E.R. 705-706]

. . . do with them; and I think some — at least some that you'll agree on.

THE COURT: And what . . . is the list your fifteen-page list?

MR. BOWLES: Fifteen-item list, your Honor?

THE COURT: Yes, fifteen-item list.

MR. BOWLES: Yes, Sir.

MR. KEKER: Well, that's his — ours is more fundamental. I mean, ours — and I really ought to let Mr. Van Nest address some of these. But some of the objections will go to the authenticity and evidentiary value of certain exhibits that I know Mr. Bowles wants to show the jury right away.

And it is our . . . it is our strong belief that by the repetition of inauthentic evidence there's a danger of miscarriage of justice. And we want to be heard on that originally.

MR. BOWLES: What actually has happened, your Honor, in our view, is that by making this proposal what we ended up receiving back from them was an effort, I think, to reargue their late motions that they submitted to the court on Wednesday or Thursday.

As the Court looks over those items, they basically are the same items that they listed in their late motion to the Court that the Court rejected. But if they're going to keep coming up, and if we're going to have to deal with them throughout the course of trial, we'd better deal with them first.

THE COURT: All right. I'll follow the suggestion of counsel. And we'll select the jury, and then recess for an appropriate time.

Now, the question of the evidentiary hearing with respect to the best evidence rule. The case is over if the Court grants the motion made on the basis of the plaintiff's opening statement. And that argument really is the argument on the best evidence rule.

Am I correct about that?

MR. KEKER: I — I'm not sure which motion you're referring to. The motion with respect to George Lucas makes the case over as to him, but not as to the other three defendants. That motion simply will be that there has been and is not now any evidence that George Lucas did any copying, and there's no derivative theory of liability that's been put forth, so he shouldn't even be sitting here.

Their theory at best is that Joe Johnston did something wrong, and Lucasfilm and Twentieth Century is derivatively liable.

So — so we think that is completely separate from the best evidence rule. The best evidence problem is that we challenge the fact that the originals, of which copies are being produced, copies of copies of copies, ever existed at an . . .

EXCERPT FROM USDC OPINION
FILED 10/16/84 [E.R. 517]

. . . originals did exist at some time (an inescapable conclusion given the second and third generation copies sought to be offered by plaintiff), but that the originals were created following plaintiff's access to ESB materials, and have been intentionally withheld or destroyed to conceal the true date of their creation. Therefore, defendants characterize the issue as not whether the originals ever existed, but whether the originals have been lost or destroyed in bad faith, a proper preliminary determination for the Court under Rules 104(a), 1004, and 1008.

The Court finds defendant's characterization to be the correct one. First, the originals must have existed at some time so that plaintiff could create the copies he seeks to offer into evidence. This is clearly not a case in which plaintiff is seeking to offer secondary evidence in the form of oral testimony and the like, in which case a true question as to the existence of the original may be posed. Rather, defendants' contention is that the originals existed and were destroyed in bad faith, or still exist and are being intentionally withheld.

Second, whether the originals were created prior to plaintiff's access to ESB materials or following that access is of little consequence when considered in light of the purpose of the "best evidence" rule. Although the "best evidence" rule is designed to facilitate the use of secondary evidence when there is a need to allow that evidence to be used in lieu of the original, the rule is also designed to keep out secondary evidence when its admission would be contrary to the furtherance of justice. A copy is always liable to error, whereas this contingency wholly disappears when the original is produced. 4 Wigmore on . . .

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

LEE M. SEILER,
Plaintiff-Appellant,
v.
LUCASFILM, LTD., INDUSTRIAL LIGHT AND MAGIC, TWENTIETH CENTURY-FOX FILM CORPORATION, GEORGE LUCAS, JR., and JOSEPH E. JOHNSTON,
Defendants-Appellees.

CA No. 85-1955
DC No. CV-83-696-WHO
(Northern California)

ORDER

FILED: Feb. 17, 1987
Before: FARRIS, and BOOCHEVER, Circuit Judges, and KEEP,* District Judge.

The panel as constituted in the above case has voted to deny the petition for rehearing. Judge Farris has voted to reject the suggestion for a rehearing en banc and Judges Boochever and Keep recommend rejection.

The full court has been advised of the suggestion for an en banc hearing, and no judge of the court has requested a vote on it. Fed. R. App. P. 35(b).

The petition for rehearing is denied and the suggestion for a rehearing en banc is rejected.

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*The Honorable Judith N. Keep, United States District Judge for the Southern District of California, sitting by designation.

PROOF OF SERVICE BY MAIL

I am a citizen of the United States and a resident of the City and County of Los Angeles; I am over the age of eighteen years and not a party to the within action; my business address is: 1706 Maple Avenue, Los Angeles, California.

On July 10, 1987, I served the within Brief in Opposition to Petition for Writ of Certiorari in re: "Lee M. Seiler vs. Lucasfilm Ltd., Twentieth Century-Fox Film Corporation" in the United States Supreme Court, October Term 1986, No. 86-1965:

On the Parties in said action, by placing Three copies thereof enclosed in a sealed envelope with postage fully prepaid, in the United States post office mail box at Los Angeles, California, addressed as follows:

Elliott L. Bien
Paul H. Cyril
Bronson, Bronson & McKinnon
555 California Street
Suite 3400
San Francisco, CA 94104

John R. Murtha
1253 Larch Avenue
Moraga, CA 94556

All parties required to be served have been served.

I certify (or declare), under penalty of perjury, that the foregoing is true and correct.

Executed on July 10, 1987, at Los Angeles, California

Ce Ce Medina

CE CE MEDINA